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Supreme Court of the United States,

OCTOBER TERM, A. D. 1902.

No. 42.

WILLIAM R. WARNER, EXECUTOR OF THE ESTATE OF WILLIAM R. WARNER, DECEASED, APPELLANT,

vs.

THE SEARLE & HERETH COMPANY, GIDDON D. SEARLE, FRANK S. HERETH, AND O. T. HASTMAN, APPELLEE.

Appeal from the United States Circuit Court of Appeals for the Seventh Circuit.

BRIEF IN BEHALF OF APPELLANT.

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Supreme Court of the United States.

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No. 307.

WILLIAM R. WARNER, EXECUTOR OF THE ESTATE OF WILLIAM R. WARNER, DECEASED, APPELLANT,

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THE SEARLE & HERETH COMPANY, GIDEON D. SEARLE, FRANK S. HERETH, AND O. T. EASTMAN, APPELLEE.

Appeal from the United States Circuit Court of Appeals for the Seventh Circuit.

BRIEF IN BEHALF OF APPELLANT.

May it please the Court:

A motion was made by appellees in this cause to dismiss the appeal upon the ground that the court is without jurisdiction to hear and determine such appeal. This motion was presented to the Supreme Court in the spring of 1903, but its consideration was postponed by your Honors until the cause came up on its merits. There is, therefore, now pending before your Honors for determination a motion to dismiss the appeal and the appeal itself on the merits. We will discuss these matters in the order named.

MOTION TO DISMISS FOR ALLEGED LACK OF JURISDICTION.

The motion to dismiss for want of jurisdiction is based upon the allegation that the jurisdiction of the United States Circuit Court was dependent entirely upon the fact that the opposite parties to the suit were citizens of different states, and that in such cases the decree of the Circuit Court of Appeals is made final by the provisions of the statute.

Sections 5 and 6 of the Act creating the U. S. Circuit Court of Appeals, approved March 3, 1881, regulate the tribunals to which appeals may be taken.

Section 5 provides:

> "That appeals or writs of error may be taken from the district courts or from the eixsting circuit courts to the Supreme Court in the following cases:
>
> "In any case in which the jurisdiction of the court is in issue; in such cases the question of jurisdiction alone shall be certified to the Supreme Court from the court below for decision.
>
> "From the final sentences and decrees in prize causes.
>
> "In cases of a conviction of a capital or otherwise infamous crime.
>
> "*In any case that involves the construction or application of the Constitution of the United States.*
>
> "*In any case in which the constitutionality of any law of the United States, or the validity or construction of any treaty made under its authority, is drawn in question.* . . ."

Section 6 provides:

> "That the circuit court of appeals established by this act shall exercise appellate jurisdiction to review by appeal or by writ of error final decisions in the district courts and the existing circuit courts in all cases other than those provided for in the preceding section of this act, unless otherwise provided by law, and the judgments or decrees of the circuit courts

of appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy, being aliens and citizens of the United States or citizens of different States; also in all cases arising under the patent laws, under the revenue laws, and under the criminal laws and in admiralty cases. . . .

"*In all cases not hereinbefore, in this section, made final there shall be of right an appeal or writ of error or review of the case by the Supreme Court of the United States where the matter in controversy shall exceed one thousand dollars besides costs.* . . ."

In view of the above sections of the statute, we contend that we have the right of an appeal to the Supreme Court for the following reasons, to wit:

1. This case arises under the trade-mark laws of the United States, as the trade-mark involved is a registered trade-mark, No. 9,911, registered December 26, 1882, duly offered in evidence and reprinted on page 165 of Record; and appeal to the Court of Appeals is not made final.

2. Because this is a case in which the constitutionality of the statute of the United States authorizing the registration of trade-marks, and the institution of suits for their enforcement, is drawn in question, and involves the construction or application of the Constitution of the United States.

Considering more at length the first proposition, it is to be noted that the sections of the statute quoted explictly give jurisdiction to the Supreme Court in all cases not made final in the Court of Appeals, and as trade-mark questions are not made final nor mentioned in said section, it follows that an appeal in such cases must lie to the Supreme Court of the United States, where the matter in controversy shall exceed one thousand dollars be-

sides costs. In this case the proofs show that the matter in controcversy exceeds two thousand dollars besides costs, as may be seen from the evidence on pages 179, 180 and 181 of Record.

Appellees in their brief contend that the suit, both as to the pleadings and as to the evidence, was based entirely upon the common-law trade-mark and not on the registered trade-mark. This is an error of fact, as we will now prove.

PLEADINGS BASE SUIT UPON REGISTERED TRADE-MARK, AND PROOF SUPPORTS PLEADINGS.

On page 2 of the printed record, in paragraph 2 of the bill of complaint, it will be found the usual allegations are made regarding complainant being the proprietor of the trade-mark, and having filed in the United States Patent Office an application for registration, and having duly complied with the prerequisites for such registration, and having received certificate No. 9911, registered December 26, 1882, of which a copy was attached to the bill, marked "Exhibit A." And in the same paragraph it will be seen that it is duly set forth that such "trade-mark was used in commerce with foreign nations and Indian tribes, and especially in commerce with New South Wales and Victoria." The registration certificate is also referred to in paragraph 5 on page 3 of the Record.

Paragraph 6 of the bill of complaint charges that the defendants—

> "have before the commencement of this suit, without the license and authority and against the will of your orator, and in violation of your orator's rights and privileges, counterfeited, *copied and colorably imitated the trade-mark registered* as belonging to your orator, and the mark or symbol specified as

used by your orator, and have affixed such mark or symbol to a medicinal preparation of the same general nature as that manufactured by your orator."

Again in paragraph 8 of the bill, on page 5 of the Record, it is asserted that the defendants were duly notified of the "registration in the Patent Office of his trade-mark, and has requested them to desist from their infringement of the same." And in paragraph 9, page 6 of the Record, it will be seen *that prayer is specifically made that the defendants shall be enjoined from infringing "the trade-mark set forth in the certificate of registration and declaration issued out of the United States Patent Office as No. 9911," etc.*

This reference to the bill of complaint we think will fully answer the contention of counsel for appellees that the pleadings rely entirely upon the common-law trade-mark and the jurisdiction of the court depends upon the diverse citizenship of the parties. It is true that the bill of complaint, in addition to setting up the registration of the trade-mark and asking for an injunction under the rights conveyed thereunder, also sets forth in detail the property rights of the complainant in the trade-mark, and the fact that the defendants had violated such property rights and had been guilty of unfair competition in trade. These additional allegations were precautionary and such as are usual in all properly drawn bills of complaint based upon a registered trade-mark. They were especially necessary allegations in the circuit where the bill was brought, to wit, the Seventh Circuit, for in that circuit the Court of Appeals seems to pay no regard to registered trade-marks, and has on more than one occasion expressed doubts as to the constitutionality of the law relating to such registered trade-marks, notably in the case of *Illinois Watch Co.* v. *Elgin National Watch*

Co., 94 Fed. Rep., 667. Naturally, therefore, when this case was presented to the Court of Appeals of the Seventh Circuit one of the grounds put forward as giving jurisdiction to the court was that complainant had a common-law right to the trade-mark and that the parties were citizens of different states; but the right under the registered trade-mark was also insisted upon, both in the brief before the Court of Appeals and at the oral argument, and special attention called to the registered trade-mark printed in the Record. The fact that the bill, as we have shown, specifically alleges the registration of the trade-mark and the complainant's rights thereunder and asks for an injunction for the violation of such trade-mark as registered (paragraph 9 thereof) shows conclusively that the pleadings recognize the registered trade-mark as a basis of right.

We note that on p. 3 of appellees' original brief on the motion to dismiss the point is made that there is no definite allegation and no showing that the complainant ever used the alleged trade-mark in commerce with a foreign nation or an Indian tribe since the year 1882, when two consignments were made to Australia. This is an entirely immaterial point, as we submit. Why should the complainant allege in his bill of complaint or even attempt to prove every use in commerce with foreign nations? There is nothing in the statute requiring any such allegation or proof, and nothing in sound sense to necessitate it. Complainant did allege, as is admitted, that the trade-mark was used in commerce with foreign nations prior to the registration, and gave instances of nations with which it was so used, and that is amply sufficient. Complainant could have proceeded to prove that it had been used in commerce with almost every civilized foreign nation and probably during almost every month since the registra-

tion as well as before, but of what avail would that have been? It simply would have increased the bulk of the record without accomplishing any useful object. The essential feature to allege in the bill of complaint in regard to this matter, and to prove, was that the trade-mark had been used, prior to the registration, in commerce with foreign nations, and this was alleged in the trade-mark itself, was alleged in the bill of complaint, and is established by the evidence. On page 33 of the Record it will be found that Mr. Warner, the original complainant, testified that in 1881 he shipped goods having this trade-mark to W. H. H. Lane, Sydney, N. S. W., Australia, the total value of which single shipment was over thirty-three pounds, or in other words, about $165; and in further evidence of the fact a copy of the page of the book in which this sale was recorded was by consent made on the Record. This is further confirmed by the testimony of F. M. Ramsey, answers 13 to 15, page 37, Record. Mr. Ramsey also refers to other shipments to foreign countries in his answer to question 40, page 40, Record. Mr. Remick, in answer to question 5, speaks of the shipments of advertising matter and samples to many countries. The registered trade-mark was also put in evidence and is reprinted on pages 165 and 166, Record.

We submit, therefore, that the pleadings and the evidence show that the registration was relied upon, and that the prerequisite as to alleging commerce with foreign nations and proving commerce with foreign nations was duly complied with.

It follows, therefore, that this case arises under the trade-mark laws of the United States, and therefore is not excluded from being appealed to the Supreme Court by the act establishing the Circuit Court of Appeals; but is expressly included in the last paragraph of Section 6,

which provides that in all cases not made final by such section in the Court of Appeals there shall be a right of appeal to the Supreme Court.

We are absolutely unable to see any possibility of a different construction of the statute as to the jurisdiction of the Supreme Court, for its terms are explicit and unequivocal, and any other attempted interpretation would do violence to the express wording of such statute.

THE USE BY DEFENDANT IN COMMERCE WITH FOREIGN NATIONS IS QUESTION OF MERITS, NOT OF JURISDICTION.

We understand that the contention will be made in behalf of appellees that complainant in the Circuit Court has not adduced proof to the effect that defendants have used their trade-mark in commerce with foreign nations or Indian tribes, and for this reason cannot maintain its bill. It is proved beyond peradventure that complainant used its trade-mark in commerce with foreign nations prior to the filing of the bill of complaint, and, as we understand, this is admitted; and due proof has also been made that defendants have copied or counterfeited this trade-mark and used it on their goods. In view of this state of facts, we submit that the question raised by defendants as to lack of proof of the use of the trade-mark by defendants in commerce with foreign nations and Indian tribes is irrelevant to the question of jurisdiction, and instead goes to the merits of the case. In short, appellant submits that the jurisdiction of the lower court attached when the bill was filed and the register[illegible] trade-mark introduced in evidence and proof adduced that the complainant used its trade-mark in commerce with foreign nations, and perhaps even before this time. Whether or not defendants are proved to have used a similar trade-

mark in commerce with foreign nations or Indian tribes is a question not going to jurisdiction or the right of appeal, but appertaining to the merits of the cause. It is purely a question as to the sufficiency of proof of infringement. Whether complainant was required to prove that defendant used a similar trade-mark in commerce with foreign nations or Indian tribes (which we deny, and will hereafter attempt to establish the propriety of such denial), or whether it has adduced sufficient evidence to prove such fact, are questions which have nothing to do with the right of appeal or the jurisdiction of the court, but instead bear solely upon the proof of infringement. We will discuss this question, however, under another heading.

THE STATUTE REQUIRES USE BY REGISTRANT IN FOREIGN COMMERCE, BUT NOT FOREIGN USE BY INFRINGER.

The Act of 1870 relating to trade-marks was declared unconstitutional by the Supreme Court in *U. S.* v. *Steffens,* 100 U. S., 82, and proceeding in the direction of the reasoning of the court, that trade-mark legislation could only be founded on the commerce clause of the constitution which related to commerce between the several states and between foreign nations and Indian tribes, Congress, by the Act of March 3, 1881, prescribed new restrictions with relation to the registration of trade-marks and suits in the federal courts under such registrations, the important point of which was to provide that as a prerequisite of such registration the owner of the trade-mark must have used it in commerce with foreign nations or Indian tribes. Section 7 of the Act of March 3, 1881, then provided that the registration of the trade-mark should be *prima facie* evidence of ownership,

and that any person who should counterfeit it should be liable to an action on the case for damages, and that the party aggrieved should also have his remedy in equity to enjoin the wrongful use of such trade-mark and to recover compensation therefor, and that the courts of the United States should have original and appellate jurisdiction in such cases without regard to the amount in controversy. The first question which arises under these sections of the Act of 1881 is, whether the use of a trade-mark, so registered, by a defendant in the United States is capable of being enjoined by the federal courts, and if, as we contend, this question shall be answered in the affirmative, under the express wording of the statute, then, next, whether such a statute is valid under the constitution. In the case of *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 87 O. G., 2323, the Court of Appeals for the Seventh Circuit threw doubt upon the constitutionality of this clause of the statute. An appeal was taken to the Supreme Court of the United States, but the case went off on the question of merits, the court not passing upon the constitutionality of the Act of Congress. The Supreme Court seemingly, however, must have entertained a favorable view of the constitutional question or they would not have entertained the case at all. In other words, they assumed jurisdiction and passed upon the merits of the case, which, as we submit, was virtually a decision in favor of jurisdiction and the constitutionality of the Act of Congress. However, we will now discuss this matter in the several aspects of it which have been presented to us. Let us now examine carefully the exact language of the congressional enactment. The preamble of the section of the statute is as follows:

> "That owners of trade-marks used in commerce with foreign nations or with Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country, or tribes which by treaty, convention or law, afford similar privileges to citizens of the United States, may obtain registration of such trade-marks by applying, etc. . . ."

It will be seen by the foregoing quotation that in order to obtain registration a party must be, first, the owner of the trade-mark; and secondly, he must use it in commerce with foreign nations or with Indian tribes. These two conditions having been fulfilled he may obtain registration of such trade-mark. Section 3 of the same Act of Congress is of the same import, and it is as follows:

> "No alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, . . . etc."

Now, in the present case Mr. Warner alleged in his bill of complaint that he had lawfully registered his trade-mark, and offered in evidence the registered trade-mark, in which it is asserted that he had used such trade-mark in commerce with foreign nations.

We next turn to Section 7 of the same act, and find the first sentence is as follows: "That registration of a trade-mark shall be *prima facie* evidence of ownership." So that, unless there was some proof to the contrary in this case, the proof of registration is sufficient to establish that Mr. Warner was the owner of the trade-mark. But not only is there no evidence against Mr. Warner's claim of ownership, but it is shown by the deposition of Mr. Warner himself, and by the deposition of Frank R. Ramsey, that he adopted the trade-mark as early as 1876 and prior to the registration used it in commerce with foreign nations, and particularly with New South Wales,

to which country he adduced evidence of the shipment of goods with the trade-mark attached. There has been no attempt to dispute this evidence, and consequently it must be admitted that William R. Warner was the owner of the trade-mark, and duly complied with the prerequisites for its registration and duly obtained the registration.

The evidence also shows that the defendants used a similar mark upon goods sold in the State of Illinois and elsewhere, and the question next to be considered is whether the counterfeiting of this mark and the use of the same on goods sold in Illinois is an infringement of the registered trade-mark, or must it be shown that the defendants not only copied and counterfeited such trade-mark, but that they used such counterfeit trade-mark in commerce with foreign nations or Indian tribes. This brings us to a consideration of the exact language of Sec. 7 of the Act of Congress of 1881, which is as follows:

> "SEC. 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall *reproduce, counterfeit, copy or colorably imitate any trade-mark registered under this act and affix the same to mechandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade-mark,* at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy."

This section of the statute makes four provisions, to

wit: First, that the registration of the trade-mark shall be *prima facie* evidence of ownership; second, it defines the offense in explicit language when it says, "Any person who shall reproduce, counterfeit or colorably imitate any trade-mark registered under this act and affix the same to mechandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the *wrongful* use of such trade-mark, at the suit of the owner thereof;" thus stating specifically that the counterfeiting of the registered mark and the affixing of such mark upon merchandise of substantially the same properties as those described in the registration is "the wrongful use" of said trade-mark. There is nothing here defining the wrongful use as a use in commerce with foreign nations or Indian tribes, but, on the contrary, a specific declaration by the legislature that the wrongful use of the registered trade-mark is the counterfeiting or colorable imitation of it and the affixing of the same to mechandise of substantially the same descriptive properties as those described in the registration. Third, there is the remedy provided in the action on the case for damages for such wrongful use. There seems to be no possibility of misunderstanding the language of this section of the statute, in so far as we have referred to it. The offense, the wrongful use, for which the party is liable to an action on the case, is stated plainly to be the counterfeiting of the registered trade-mark and affixing the same to mechandise having substantially the same descriptive properties, and it would indeed require judicial legislation, and, we submit, strong imagination, to understand these words to mean, not what they say, but additionally that after the mark properly registered shall have been counterfeited and affixed to goods having substantially the same descriptive prop-

erties, no action on the case for damages would lie unless the wrongful user should also sell the goods, so improperly marked, to foreign countries or Indian tribes. Congress unmistakably declares that the counterfeiting of the registered trade-mark and the affixing of it upon goods of the same descriptive properties shall be a wrongful use for which an action for damages will lie; and the counterfeiting of the registered mark and affixing it to goods of similar properties is defined to be the wrongful use, unrestricted by the locality to which said merchandise is to be sent by such wrongful user. It is manifest that this was the only way of giving an adequate remedy. If Congress had provided that in order to constitute the offense or wrongful use, not only should there be counterfeiting of the mark and the affixing of it to goods of similar properties by the defendant, but he should, as a third step, send such goods into foreign countries, it is manifest that the remedy would have been practically worthless. It would be impossible to follow every bottle or package sold anywhere in the United States with the mark upon it to its ultimate destination. Canadians, for instance, could step across the border into the United States and buy at points along the whole boundary line quantities of the goods with the fraudulent trade-mark upon them, and subsequently export them into their own country. To attempt to reach and stop the persons who actually exported into Canada would be like attempting to stop each stream of a sprinkling cart by an individual valve instead of stopping the flow through the main pipe by a single valve. It was evidently the purpose of Congress to strike at the fountainhead by stopping the counterfeiting and affixing of the mark, instead of following each particular package into the hands of the consumer, and the language of the statute plainly expresses this idea.

Whether this was within the power of Congress, we will presently discuss. It certainly seems to have been clearly its intention and is plainly expressed in its language. What, then, is the argument against this construction of the seventh section of the statute? It is based on the language after the semicolon in the section, which is as follows:

> "and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid."

It is argued that according to this section of the statute equity may only interfere to enjoin the use of the counterfeited trade-mark in foreign commerce or commerce with Indian tribes. In the first place, this interpretation of the second clause of the section would be antagonistic to the plain expression in the first clause, and would give a remedy in equity more limited and restricted than the remedy at law, for, as we have seen, the remedy at law is expressly stated to be applicable against any one who counterfeits the trade-mark and affixes it to mechandise of the same descriptive properties, which is characterized as a wrongful use, and yet it is urged that in equity the statute intends to give jurisdiction only when this trade-mark is used by the defendant in foreign commerce or commerce with Indian tribes. This, we submit, is a construction which would make the two clauses of the section opposed to each other, and therefore one which under the rules of interpretation should not be adopted. And, besides, the language itself, when fairly construed, does not bear the interpretation thus argued for it. In the first place, it provides that the remedy according to the course of equity is to enjoin the wrongful use, which

has already been defined in the statute as a counterfeiting and affixing of the trademark, without reference to the point of consumption of the goods. Again, this second clause of the section refers to the wrongful use of "*such* trade-mark," and the only trade-mark which can be referred to by "such" is the registered trade-mark, the wrongful use of which is to counterfeit and affix to goods. Further, the language employed says, "the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid." These words, "*as aforesaid*," have great significance in this connection. They cannot be understood as redundant or useless, and the only trade-mark before referred to in the section and which must therefore be intended by the words "as aforesaid," which was used in foreign commerce or commerce with Indian tribes is the registered trade-mark. Now let us make a comparison of the two interpretations of this second clause of Sec. 7 of the Act, and see what is more natural. We contend that the clause should be read as follows:

> "and the party aggrieved (that is, the complainant) shall also have his remedy according to the course of equity to enjoin the wrongful use or counterfeiting of the trade-mark used by complainant in foreign commerce or commerce with Indian tribes, as aforesaid."

The other interpretation would make the clause read:

> "and the party aggrieved (the complainant) shall also have his remedy according to the course of equity to enjoin the wrongful use or counterfeiting of such trade-mark used by defendant in foreign commerce or commerce with Indian tribes, as aforesaid."

By our interpretation the words "as aforesaid" refer to the word "used," and mean used by complainant, be-

cause no one else has been described by the Act as having used the trade-mark in foreign commerce. By the other interpretation the words "as aforesaid" refer to the word "used" in connection with the defendant, but as the defendant had not before been mentioned in the Act as having used the trade-mark in foreign commerce, the words are not correctly applicable. In Sections 1, 2 and 3 of the Act the complainant's mark was described as being *used* in commerce with foreign nations or Indian tribes, and therefore the words "as aforesaid," when coupled with the use in foreign commerce, etc., necessarily refer to the use by the complainant, for the defendant had never been described as having used the trade-mark in commerce anywhere, but merely referred to as the counterfeiter who had affixed the trade-mark to goods of the same properties.

Why should the section referred to, in the second clause thereof, employ the word "use" just before the word "trade-mark," and the word "used" just after the word "trade-mark," if in both instances the person referred to was defendant? By "use" was certainly meant defendant's use, and if it was also meant that the word "defendant" should come after "used" so that it would read "trade-mark used by defendant," then the sentence would be tautological and awkward. If, on the other hand, reference was had to wrongful use by defendant of such trade-mark used by complainant in foreign commerce or commerce with Indian tribes, as aforesaid, then the sentence was clear and the employment of the two words was necessary, for it was an equivalent way of saying the trade-mark registered to complainant. The whole expression "trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid," is manifestly employed to designate the thing that was infringed,

that is, the complainant's trade-mark, and not the act of infringing which constituted the wrongful use. Thus interpreted, all the parts of the section, and indeed of the other sections of the statute, harmonize and become consistent with each other. There is no difficulty in interpreting the section unless it is attempted to apply it to defendant's use, and then comes doubt, conflict with other clauses of the statute, the necessity of construing some of the words as superfluous, and the absolutely inaccurate use of the expression "as aforesaid." Additionally we have under this last form of interpretation the remedy at law expressly applied to the mere counterfeiting and affixing, and the remedy in equity more limited, with no reason for this difference. In view of these considerations, we submit that it is perfectly clear that the statute intended that the wrongful use for which remedial action was given should be the counterfeiting and affixing, irrespective of the locality to which the goods were to go.

The legality of the registration depends of course on use in a foreign trade by the registrant, and this was made necessary by the construction of the constitution adopted by the Supreme Court in the case before cited, but nothing more was necessary and nothing more was therefore required by Congress in order to establish the right. Congress was manifestly legislating in the interests of *bona fide* owners who ought to have the exclusive right to their marks, and it would naturally go as far as it could in protecting that mark so as to prevent its fraudulent use anywhere, which it could and did do, by plainly enjoining the counterfeit imitation of such mark and the affixing of the same to goods having similar properties. There is every reason, therefore, for construing the statute broadly in this respect, and none for construing it in the more restricted manner.

Appellees make reference to Sec. 11 of the Statute, which reads as follows:

> "That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe."

This section gives us no further light on the matter. It does not specify by whom the goods are to be intended to be used, whether the complainant or the defendant, and we submit that it manifestly infers use by complainant, because in that way only can it be made to harmonize with the remedy by action on the case under Sec. 7 of the same statute, which, as we have seen, provides a remedy against any person who shall copy a trade-mark registered under this Act, and affix the same to merchandise of substantially the same descriptive properties, whether the person who copies uses it in commerce with foreign nations or in domestic commerce. And, again, elsewhere in the Act, the use in commerce with foreign nations by the registrant is referred to, and the registrant must be the complainant in any suit, and, therefore, if the registrant and complainant uses the trade-mark on goods "intended to be transported to a foreign country," and a defendant copies such trade-mark, he is guilty of a wrongful act, as is declared in Section 7, and is liable to an action on the case, whether the defendant uses it or intends to use it in domestic or foreign commerce, for the wrongful act is the copying or counterfeiting and affixing it to goods of a similar character, as we have heretofore shown.

It is true, there are some Circuit Court cases (which

are cited in appellee's brief) which seem to construe this statute differently, and hold that the use, to constitute infringement, must be use in a foreign country by defendant. We think it will be found from an examination of these cases that the contra of the proposition was not properly presented to the court, and we merely submit as to these decisions that they are manifestly wrong, in view of the letter and the spirit of the statute.

In the case of *Illinois Watch Case Co.* v. *Elgin National Watch Co.*, 94 Fed. Rep., 667, the Circuit Court of Appeals for the 7th Circuit used language which possibly might mean that in order to prove infringement it would be necessary to prove that the defendant employed the trade-mark in foreign commerce or commerce with Indian tribes. This ruling was made a ground of error and the point taken before the Supreme Court of the United States. The case was decided by the Supreme Court and reported in 179 U. S., 665, but the opinion did not touch upon this point. Inasmuch as the question of jurisdiction lay at the threshold of this Illinois Watch Case Company case, it would seem that the Supreme Court must necessarily have considered the question before passing on to the merits of the cause, and have assumed that it had jurisdiction, nothwithstanding the fact that the defendant had not used the trade-mark in commerce with foreign nations or Indian tribes, while the complainant had so used it, as in this case. While the opinion of the Supreme Court does not express its views on this point, we submit that its action in assuming jurisdiction and passing upon the merits of the cause virtually amounted to construing the statute in the manner for which we contend.

THE CONSTITUTIONALITY OF THE TRADE-MARK ACT IS DRAWN IN QUESTION.

Assuming, then, that the statute merely requires that the owner of the trade-mark shall establish use in commerce with foreign nations or Indian tribes, and that being done inhibits the counterfeiting of such trade-mark and affixing it to goods having similar properties as the registered trade-mark, is such a statute constitutional? We submit that it is. Art. I, Sec. 8, Par. 3 of the constitution, gives Congress power "to regulate commerce with foreign nations, and among the several states, and with the Indian tribes," and supplements this by paragraph 18, which authorizes Congress "to make all laws which shall be necessary and proper for carrying into execution the foregoing powers." These powers have been recognized by the Supreme Court many times. *Addyston* v. *United States,* 175 U. S., 211, 228; *United States* v. *Joint Traffic Assn.,* 171 U. S., 505; *Gibbons* v. *Ogden,* 9 Wheaton, 196; *Brown* v. *Maryland,* 12 Wheaton, 419. Congress is therefore the sole judge as to what laws are necessary and proper for carrying into execution the power thus given. This was decided in *McCulloch* v. *Maryland,* 4 Wheaton, 316, where it was said:

> "The sound construction of the constitution must allow to the national legislature that discretion, with respect to means with which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it, in the manner most beneficial to the people." . . .

Following the doctrine of that decision, it will be seen that Congress has in the present instance legislated regarding trade-marks and their infringement in a manner which, while strictly within the powers conferred upon it by the constitution, yet is most beneficial to the people.

Of course we do not mean to say that the courts should not have the power or right to inquire whether trade-marks bear such relation to commerce as to bring them within legislative control, for that was distinctly affirmed in Trade-Mark Cases, 100 U. S., 95, but the indications of the same decision are to the effect that trade-marks do come within the commerce clause of the constitution, and that being so, Congress has the right, as before stated, to use its discretion in carrying out the spirit of the constitution in such a manner as will be most beneficial to the people. In *Hopkins* v. *United States,* 171 U. S., 578, the Supreme Court interpreted interstate commerce as:

> "intercourse for purposes of trade in any and all its forms, including transportation, purchase, sale, and the exchange of commodities between citizens of different states, and the power to regulate it embraces all the instrumentalities by which such commerce may be conducted."

Now a trade-mark is one of the instrumentalities by which commerce is conducted. It is a distinguishing mark placed upon goods for the purpose of indicating the origin and ownership, and its very purpose is to advise people at a distance from the manufacturer that this is the goods of that particular manufacturer; and it has been decided by the Supreme Court that the power of Congress over commerce with foreign nations is co-extensive with its power over interstate commerce. *Bowman* v. *Chicago & Northwestern Ry. Co.,* 125 U. S., 465.

The enactments of Congress, therefore, relating to trade-marks and their violation are a part of the necessary legislation for carrying into execution the power given to the constitution to regulate commerce with foreign nations and among the several states, and as we have seen, the discretion is vested in Congress to make these

regulations in accordance with the best interests of the people. If trade-marks had no connection with commerce, legislation with reference to their protection and violation must necessarily be a mere usurpation of power; but if they have any material connection with it, then the power and duty of Congress to regulate their use in commerce with foreign nations would seem to be unquestionable. The name "trade-mark" itself indicates that it is a mark connected with commerce or trade, and therefore an instrumentality such as is referred to in *Hopkins* v. *United States, supra.* A trade-mark has likewise been decided to be " a property right," Trade-Mark Cases, 100 U. S., 82, and "is a subject of commerce," *Fulton* v. *Sillers,* 4 Brews., 42 Pa.

If, then, a trade-mark is a property right and is a subject of commerce, as has been established by the decisions referred to and Congress has the right by legislation to regulate the manner of carrying into execution the commerce with foreign nations including this subject of commerce—a trade-mark—then why has it not the right in its own discretion, and in the direction of what it regards as the best interests of the people, to enact the statutes to which we have heretofore referred relating to trade-marks? It is manifestly much better for the owner of the trade-mark, and much better for the public at large, that a trade-mark which has been proved to be actually used in commerce with foreign nations by a registrant, and which has the seal of the Patent Office upon it, shall be protected against counterfeiting absolutely rather than partially. It is much better for the owner of the trade-mark, and for the public at large in this and in foreign countries with whom the commerce is carried on, that the trade-mark which the public has associated with a particular class of goods manufactured by a particular

person, firm or corporation, shall not be counterfeited or imitated at all, and that there shall be a remedy prescribed to prevent such counterfeiting or simulation, irrespective, however, of where the original copying is done. It is much better for the public and the owner of the trade-mark that Congress shall strike at the fountain-head and cut off the source of the simulation or counterfeiting, rather than to attempt to follow each article, upon which the simulation is placed, to its ultimate destination, which latter would be an impracticable journey. Congress in these sections of the statute referred to has said in effect: The constitution permits us to regulate commerce with foreign countries and to use our discretion as to the instrumentalities necessary to best protect the public; and in the exercise of that discretion we deem it for the best interests of the rightful owners of trade-marks who are using such trade-marks in commerce with foreign countries, and therefore have the right to appeal to us for protection, to prohibit the counterfeiting or imitating of these trade-marks and the affixing of the same upon goods of like nature, irrespective of the locality where the infringers' goods are to be used. The property right is the trade-mark, not the commodity to which it is attached. Congress has the right to say, as commerce with foreign nations is likely to be injured by the copying or counterfeiting of a trade-mark which is used in such commerce, we prohibit the counterfeiting or imitation of such trade-mark and affixing the same to similar goods, and do this as a necessary instrumentality to protect the owner of the trade-mark in his use of the same in commerce with foreign nations, and the public in their belief in the integrity of the mark which we have guaranteed by registration as indicative of ownership. It was in this same spirit that

by the Act of October 1, 1890, Congress required that imported articles of foreign manufacture should not be admitted to entry unless "plainly marked, stamped, branded or labeled in legible English words, so as to indicate the country of their origin." If Congress had full authority over the subject of marks employed in such commerce, why has it not full authority over marks employed in export commerce? In the one case it provides that goods cannot come into the country unless properly marked; and in the other case it provides that goods cannot leave the country or the manufacturer's hands if they are improperly marked in a manner simulating a mark that has habitually been applied to goods leaving the country by its rightful owner. Congress must get its jurisdiction, it is true, from international commerce, but having once acquired that jurisdiction by virtue of international commerce in which the trade-mark is employed, it can provide a remedy against interference with that international commerce, which will be an adequate remedy, by stopping such interference at its point of beginning, and not awaiting its journey over innumerable roads. Congress has said to every owner of a trade-mark: "Establish your right to that trade-mark and establish that you are using it in commerce with foreign nations or Indian tribes so as to give us the justification for protecting you in that trade under the constitution, and we, in behalf of the people and under the powers given us by the constitution, will stop fraudulent and improper interference with that trade by the means best adapted to that end, to wit, by directing the courts to enjoin parties who counterfeit the trade-mark and affix it to goods of a similar description, whether such goods are sent abroad by the parties making them or not, for we appreciate that the danger of interfering

with this foreign commerce threatens immediately the goods are manufactured and marked, and unless we authorize the stopping of this impending danger as soon as it threatens irreparable loss is likely to result. Congress evidently foresaw the impracticability of preventing the goods with the fraudulent mark being sent across the border unless the counterfeiting of the mark itself was prohibited; and foresaw that to apply the remedy after the damage was done—that is, after the goods were sent across the border—would be entirely inadequate, and for that reason declared that the wrongful use of a duly registered trade-mark, which trade-mark had been used in commerce with foreign nations, might be stopped by resort to equity and thus the danger which threatened the moment the counterfeiting of the mark and affixing it to the goods happened could be avoided and rendered harmless. It was the only way to provide an adequate remedy, and it was adopted.

We submit that this interpretation of the Act of Congress not only brought the Trade-Mark Statute within the purview of the constitution, but likewise complied with the letter of the *Statute*, and with tht object and spirit of the act, and provided an adequate remedy which is the only one which would suffice in view of the purpose intended. The contrary interpretation to the effect that Congress intended only to inhibit the use of the trade-mark in commerce with foreign nations by the infringer would be against the language of the statute, antagonistic to its purpose, and practically destroy the whole value or protection intended to be afforded by the statute. It is not necessary to cite authorities to establish the rule that the interpretation of the statute which would be in harmony with its letter and in harmony with its spirit and purpose is to be preferred to a construction which

would be a strained use of the language employed and which would utterly defeat the spirit and object of the law.

We submit that an appeal to the Supreme Court in the present case is therefore additionally necessary, because the constitutionality of the statute of the United States authorizing the registration of trade-marks, and the institution of suits for their enforcement, is drawn in question, and because the case involves the construction or application of the constitution of the United States to a particular course of action; both of which grounds are declared by the statute establishing the Circuit Court of Appeals as authorizing an appeal to the Supreme Court.

And, finally, the facts of this case bring it within the federal statute relating to the registration of and violation of trade-marks and the remedy for the enforcement of the law. As we before observed, however, whether or not the fact of use by the defendant in commerce with foreign nations is a vital question, is not properly up for solution at the time of the consideration of the motion to dismiss this appeal, for that is a question relating to the proof of infringement, and properly should come before the Supreme Court at the time of the consideration of the appeal on its merits.

By way of recapitulation we, therefore, submit:

1. That the appeal to the Supreme Court is permissible because the suit was brought under the Act of Congress relating to the registration and violation of trade-marks, and as cases of such nature are not included by inhibitions of the statute establishing the Circuit Court of Appeals and their jurisdiction, it follows that by the last paragraph of Sec. 6 of such statute the right of appeal to the Supreme Court is absolute.

2. An appeal to the Supreme Court is proper in this

case, because it involves the construction or application of the commerce clause of the constitution of the United States.

3. An appeal to the Supreme Court of the United States in this case is permissible, because the constitutionality of the statute regarding trade-marks is drawn in question.

BRIEF ON MERITS.

STATEMENT OF CASE.

This suit was originally instituted by a bill in equity, in which prayers were made for an injunction and for damages by reason of alleged infringement of a trade-mark registered in the Patent Office, in accordance with the statute, and a copy of which was attached to the bill of complaint; and which has been reprinted in the record on pages 164, 165 and 166, and designated as "Complainant's Exhibit Certificate of Registration of Trade-Mark." Full evidence for both parties was taken and the case came on for hearing and was decided by his Honor, Judge Kohlsaat, in the trial court on the 18th of December, 1900, in favor of complainant, a copy of whose opinion is reprinted on page 200, Record. The decree was filed on the same day, and is reprinted on pages 183 and 184, Record. The defendants in the trial court presented their petition for appeal to the Court of Appeals, and filed their assignment of errors, on the 31st day of December, 1900, and upon the filing of supersedeas bond the suit was suspended pending the decision of the Court of Appeals. The Court of Appeals for the Seventh Circuit made its adjudication on the 21st day of January, 1902, which was to reverse the decision of the trial court.

The opinion of the Court of Appeals is reprinted on pp. 203, 204 and 205, Record, which was amended, and is reprinted as amended on pages 207, 208 and 209, Record. An appeal was taken to the Supreme Court of the United States by the complainant in the trial court on the 18th day of February, 1902, and was formally allowed by the presiding judge of the Circuit Court of Appeals on the 7th of March, 1902. The assignment of errors was duly filed, and is reprinted on pages 212 and 213, Record. The record having been perfected in the Supreme Court, solicitors for appellees moved to dismiss for want of jurisdiction, and the consideration of this motion, as we have before observed, was postponed until the final hearing of the cause, and is the one we have heretofore discussed.

We, therefore, are now brought, in regular order, to a discussion of the merits of this suit, and the first topic is naturally a statement of the name and nature of the—

TRADE-MARK INVOLVED.

The evidence shows that William R. Warner in 1876, while he was doing business under the name of William R. Warner & Co., adopted and introduced to the public, by distributing samples all over the country, and by advertising to a large extent, a remedy for indigestion containing lactic and muratic acids, pepsin, and an extract from the organ of the pig, now known as pancreatin, and designated this mixture as "Pancreopepsin." This label was applied both directly to the bottles and also to the wrappers surrounding the bottles. When it was put up in liquid form the preparation had a pale straw color, and was called "Liquid Pancreopepsin," but when prepared as a powder the word "Liquid" was omitted. A sample wrapper thus marked with the trade-mark was

introduced in evidence and designated as "Complainant's Exhibit Trade-Marked Wrapper," and is to be found reprinted on page 161 of the Record. A sample bottle, with a similar label attached, was also offered in evidence and marked "Complainant's Product Without Wrapper." This bottle was offered in evidence and is now before the court. The registered trade-mark, with a description of it, will be found reprinted on pages 164, 165 and 166, Record. It was not pretended by Mr. Warner that he originated the several ingredients composing his remedy. Lactic acid was one of the ingredients, and that was discovered long before Mr. Warner was born. Muratic acid was another ingredient, and that was of practically equal antiquity. Pepsin was an old and well-known substance. Pancreatin had been derived from the pancreas of the hog, and designated by the name "Pancreatine" long years before Mr. Warner included it as one element in his mixture. The mixture of all these ingredients was new with Mr. Warner, but that is immaterial to this case, for we are not trying the question of novelty of the mixture. The name "Pancreopepsin" was coined by Mr. Warner, as the proof shows, and applied to this mixture containing the several elements referred to, including lactic and muratic acids, and pepsin and pancreatin. It was an arbitrary and artificial name originated and adopted by Mr. Warner for the purpose of designating his remedy, and by long association with the remedy the name gradually became identified in the mind of the public with the remedy itself. In answer 12 of his deposition, printed on page 34, Record, Mr. Warner, the complainant in the trial court, testified that he had spent, roughly stated, twelve or thirteen thousand dollars in advertising and introducing this remedy under the name of "Pancreopepsin."

COMPARISON OF COMPLAINANT'S AND DEFENDANT'S MARKS.

The complainant's trade-mark, as we have heretofore stated, is the word "Pancreopepsine." The defendants' trade-mark used upon their package is "Pancro-Pepsin." It would be very difficult for defendants, without copying every letter, to more closely imitate complainant's trade-mark than they have done. The two names are closely similar in spelling, and practically identical in sound. Defendants leave out the "e" in complainant's prefix "pancreo," and also eliminate it from the suffix "pepsine." In short, the only change in the spelling of the word consists in eliding the letter "e" from both syllables. Defendants also divide their two syllables by a hyphen. These are all the changes and they are so slight as to make it apparently unnecessary to waste any time upon discussion of their effect.

The New York Court of Appeals said that the question was whether there was such a resemblance between the two as to deceive a purchaser using ordinary caution. (*Popham* v. *Cole*, 66 N. Y., 69.)

The decision of the Supreme Court in *McLain* v. *Fleming*, 96 U. S., 245, and 13 O. G., 913, is controlling on this point. In that case the court said:

> "It is safe to declare as a general rule that exact similitude is not required to constitute an infringement or to entitle the complaining party to protection. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer's device, are such as would be likely to mislead one in the ordinary course of purchasing the goods and induce him to suppose that he was purchasing the genuine article, then the similitude is such as entitles the injured party to equitable protection, if he takes seasonable measures to assert his rights and to prevent their continued invasion."

Again in the same case it is said:

> "What degree of resemblance is necessary to constitute an infringement, is incapable of exact definition as applicable to all cases. All the courts of justice can do in that regard is to say that no trader can adopt a trade-mark so resembling that of another trader as that *ordinary purchasers,* buying with *ordinary caution,* are likely to be misled."

In the case of *Coleman* v. *Crump,* 70 N. Y., 573, which is a leading case in the state courts, it was held that it was not necessary that the symbol should be a *fac simile* or precise copy of the trade-mark, or so close an imitation that the two could not be distinguished except by an expert, or upon a critical examination by one familiar with the trade-mark.

In a recent English case of *Tea Company* v. *Herbert,* 7 English Rep. Patents and Trade-Mark Cases, page 183, Justice Cotton uses the following very pertinent language:

> "Of course, when one person imitates another's mark, he never takes it absolutely in all points. If so, there is no question. But there is always a similarity and dissimilarity, in order that he may say, 'If you look at the marks carefully you will see such a difference that you cannot be deceived.' Of course when you are told that there are two but marks and the difference is pointed out, or they are put before you so that you can see the differences, then in that case you might say there is hardly any probability of deception; but when one only is shown, there are certain incautious purchasers who would probably be deceived by the similarities which exist, the articles being the same."

In other words, in almost all cases the intentional infringer will usually take care that there are plenty of what Judge Lacombe (in *Scheuer* v. *Muller,* 74 Fed. Rep., 225) called "arguable differences" to stand upon

when brought into court, "by resemblances to the article he desires to imitate sufficient to deceive the average purchaser into buying the simulated article as and for the goods of another." (*Paris Medicine Co.* v. *W. H. Hill Co.*, 102 Fed. Rep., 150; to the same effect, *Stuart* v. *F. H. Stuart Co.*, 91 Fed. Rep., 243; *Pillsbury* v. *Flour Mills Co.*, 64 Fed. Rep., 841, and *Johnson & Johnson* v. *Bauer & Black*, 82 Fed. Rep., 662.) See, also, all the text-books on trade-marks, notably Brown on Trade-Marks, second edition, chap. 8; Upton on Trade-Marks, chapter relating to infringements, etc.

In the discussion of a number of cases which will be cited later on in this brief, this rule will also be illustrated by the character of the resemblance between the two trade-marks referred to in the decision.

PROOF OF FACT OF INFRINGEMENT.

Defendants acknowledge beginning the sale of a preparation in 1889, which was called "Liquid Pancro-Pepsin." (Searle's deposition, answer 60, page 107; Hereth's deposition, answer 72, page 52, Record.) This preparation, like the Warner preparation, contains as its principal elements pepsin, pancreatine, lactic and hydrochloric acid. Several bottles and specimens have been introduced in evidence and marked "Defendants' Exhibit Hereth's Specimen Liquid Pancro-Pepsin" (page 49, Record), "Defendants' Exhibit Package Defendants' Pancro-Pepsin Powder" (page 55, Record), "Defendants' Exhibit Defendants' Pancro-Pepsin Elixir No. 1" and "Defendants' Exhibit Defendants' Pancro-Pepsin Elixir No. 2." (Page 55, Record.) We ask special examination of the defendants' sample of Liquid Pancro-Pepsin and comparison of the same with the complainant's sam-

ple of Liquid Pancreopepsine. It will be noted that the color of the liquid is practically identical; that the word "liquid" on each bottle is identical; and that the complainant's term "Pancreopepsine" is so closely simulated by defendants' term "Pancro-Pepsin" as to deceive any ordinary person, and, indeed, experts.

Defendants allege, however, that purchasers cannot be deceived as to the origin of the goods because they place their name upon the bottle and package. This defense has been many times overruled by the courts. See the following cases: *N. K. Fairbank Co.* v. *Central Lard Co.*, 64 Fed. Rep., 136; *Battle* v. *Finlay*, 45 Fed. Rep., 796; *Roberts* v. *Sheldon*, Fed. Cases No. 11,916, and cases there cited; *Sawyer* v. *Horn*, 1 Fed. Rep., 24; *Hier* v. *Abrahams*, 82 N. Y., 519, and particular attention is directed to the decision of the Court of Appeals in *Shaver* v. *Heller & Merz Co.*, 96 O. G. 2229, where it is said the placing of a defendant's name upon the package is an "aggravation and not a justification."

In *Fuller* v. *Huff*, 92 O. G., 1621, the Court of Appeals of the Second Circuit, moreover, said:

> "It was not necessary for the complainant to attempt to discover whether a purchaser had been actually deceived, for a manifest liability to deception exists."

See also *Vulcan* v. *Myers*, 139 N. Y., 304; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S., 51; *National Biscuit Co.* v. *Baker*, 95 Fed. Rep., 135.

But in the present case we have the evidence showing that purchasers and pharmacists were actually deceived into compounding the defendants' preparation with the compound manufactured by complainant.

Mr. Andrew E. Remick testifies that this imitation, put upon the market under the name Pancro-Pepsin by the

defendants, has produced a very unfair competition. He says that he has found that the likeness is very confusing to retail druggists, and also to stock clerks in the jobbing houses, and to buyers, who come into one place of business with orders for the other preparation. (See answer 10, page 19.)

Mr. Frank M. Ramsey testifies that by reason of the close imitation of William R. Warner's trade-mark, the defendants' preparation is calculated to deceive, not only ignorant persons, but the learned profession and the druggists, the patient and the consumer. (See answers 22 to 25, page 38; answers 51 and 52, page 41.)

Albert D. Thorburn, a pharmacist, who is the manager of the very large drug store of Thomas Whitfield & Co., Chicago, says his firm sells both preparations, that is, Pancreopepsine, made by William R. Warner, and Pancro-Pepsin, made by Searle & Hereth, and that great difficulty has resulted in distinguishing between these two medicinal preparations. Shortly after he went into the store the entire stock was rearranged, and he says, "clerks repeatedly confused one preparation with the other in assorting and rearranging the stock. We have had calls from customers for this article and have had to question them as which preparation was meant—which was wanted. The names of these preparations are so nearly alike, both in pronunciation and in spelling, that we have trouble in distinguishing between them." (See answers 13 and 14, pages 17 and 18, Record.)

Andrew J. Benson is the proprietor of a drug store at 2401 Indiana avenue, Chicago, and has been an educated pharmacist for twenty odd years. He testifies that he was given a prescription on the 7th day of February, 1898, which is put in evidence and marked "Dr. Bates' William R. Warner Prescription," and which, as the prescription

shows, called for Pancreopepsine, or Mr. Warner's medicine, and that he confused it with the medicine of the Searle & Hereth Company, and filled the prescription from the bottle marked "Liquid Pancro-Pepsin," obtained from the Searle & Hereth Company. (See pages 11 and 12, Record, and especially note the prescription, a copy of which is reprinted on page 160, Record.)

Frederick E. Stolze is a druggist of twelve years' experience, whose place of business is at 261 Center street, Chicago, and he testifies that in the course of his business he has sold both the Warner preparation, called Pancreopepsine, and the Searle & Hereth Company's preparation, called Pancro-Pepsin, for many years, but that when prescriptions are given him by physicians, calling for one or the other of these preparations, he does not always know which preparation is intended, because the two names are so close as to be confusing. (See page 29, Record.)

The testimony of Mr. Remick is that a physician's prescription was sent to Eugene Weber's Pharmacy, which called for Liquid Pancreopepsine, which is Warner's trade-mark; another similar prescription was sent to Herman Fry; another to F. E. Stolze; and two others were sent to druggists outside of the city; and in all these cases the prescriptions were filled with the preparation manufactured by Searle & Hereth, called Liquid Pancro-Pepsin. (See answer 13, pages 19 and 20, Record.) This evidence might have been multiplied indefinitely, as the testimony of both Remick and Ramsey, respectively managers of the Chicago and Philadelphia houses, is that the confusion was a common occurrence, but it was thought the instances given suffice to demonstrate conclusively that not only is the Warner preparation, Liquid Pancreopepsine, so closely imitated by the Searle &

Hereth preparation, Liquid Pancro-Pepsin, that the customers or patients are misled into believing the goods of the former firm originated with the latter, but that even druggists and physicians who are experts are constantly making the same mistake. The color of the fluid is practically the same; the remedy is composed of practically the same constituent elements intended for the same purpose—that is, as a remedy for indigestion; the word "liquid" used on each is the same; and, finally, Warner's trade-name Pancreopepsine is so closely counterfeited, both in spelling and pronunciation, by Searle & Hereth's word Pancro-Pepsin that it would require very careful and acute discrimination to distinguish between them. And thus the Searle & Hereth Company are reaping where they have not sown. Warner's expenditure of $13,000 in money and about fourteen years of labor prior to the coming of the Searle & Hereth Company into the field is being diverted to the benefit of the Searle & Hereth Company contrary to the principles of equity and good conscience.

Another fact important in connection with this case is that the Searle & Hereth remedy is sold at a lower price than the Warner remedy. It naturally can be sold at a lower price because it is getting the benefit of all the advertising, sampling, etc., which has cost Mr. Warner thousands of dollars of expense and years of labor. In support of our statement that the Searle & Hereth remedy is sold at a lower price we refer to the testimony of Stolze, Remick and Ramsey. In answer to questions 6 and 7, page 29, Stolze says that he does not pay the same price for the two preparations, but that Searle & Hereth's is the cheaper. Remick, in his answer 10, page 19, gives as a material reason for the unfairness of the competition by the Searle & Hereth Company that they sell their

preparation at a cut-rate price. Frank M. Ramsey testifies that the competition principally felt by William R. Warner is that of Searle & Hereth, because they offer a similar preparation at a lower price. (Answer 22, page 38.) As we shall hereafter show, by reference to the authorities, it is well settled that one of the elements recognized by the courts as materially entering into the doctrine of unfair competition is the imitation of an article at a lower price and under a similar name. This is likewise true where it is a trade-mark which is being violated.

INFRINGEMENT BY DEFENDANTS AFTER NOTICE.

The defendants, Gideon D. Searle and Frank S. Hereth, assert that they had never heard of the medical compound manufactured and put upon the market under the name of Pancreopepsine prior to the time they began the manufacture of a similar compound under the name of Pancro-Pepsin. They allege they adopted this name in 1889. Now we will see from other evidence whether this statement is true or not. Mr. Searle testifies that he was doing business at Anderson, Ind., as a druggist, from 1874 to 1887, and during that time bought drugs and preparations from A. D. Roach, who he says represented William R. Warner & Company, of Philadelphia. (Ans. 15 and 27 to 29, pages 104 and 105.) He next admits in answer 48 that he looked over the catalogues of the firms from whom he purchased preparations in Philadelphia, which consequently means that he looked over the catalogue of William R. Warner & Company. Now, as we have seen by the other testimony, William R. Warner had been making a special effort since 1876 to introduce Pancreopepsine, by publications as well as

by traveling salesmen, and therefore necessarily this remedy which was listed in their catalogue must have been seen by Mr. Searle when he looked it over.

Again, it appears from the depositions of Mr. Remick and Mr. Warner that this preparation called Pancreopepsine was thoroughly advertised in the principal drug and medical journals in different parts of the country, which also gave the defendants ample opportunity to observe the name.

Furthermore, the defendants received direct notice of their infringement of this trade-mark. Mr. Ramsey testifies that this notice was given in writing. (See answer 46, page 40.) Mr. Hereth admits in answers 65, 66 and 67, page 52, that Mr. Warner had a representative call upon him several times and requested them to discontinue the use of the name, stating that it was doing him a wrong, but that they refused. Later he says he at one time talked of discontinuing the use of the name if Warner & Company would pay for the labels already printed. printed.

From this evidence it appears that the defendants had direct notice of the infringement and refused to desist, and that, as a matter of fact, although they deny they knew of Mr. Warner's trade-mark before they began business, yet they had access to and looked over the catalogue of William R. Warner & Company in which this medicine was listed.

In the case of *Fuller* v. *Huff*, decided by the Court of Appeals for the Second Circuit July 5, 1900, and reported in 92 O. G., 1621, the court expressed itself clearly on this point as follows:

> "Although the intent of the defendants' principal when it commenced to use the name 'Health Food' may have been innocent, the continuance after it had

> learned of complainant's prior use indicates its deliberate intention to use the name without reference to the complainant's possible prior rights." (Citing also *Orr Ewing Co.* v. *Johnston Co.*, 13 Ch. Div., 434.)

We think it is pretty clearly shown that the defendants are not innocent wrong-doers, but intentional infringers.

However this may be, the law of this Circuit is well settled that even if the defendant is innocent of intended wrong, yet if his label constitutes an infringement upon the trade-mark of another on goods of a like character he will be enjoined. In a most recent case on this subject in this Circuit, entitled *Manitowoc Pea-Packing Co.* v. *William Numsen & Sons*, 93 Fed. Rep., 196, the Court of Appeals affirmed the lower court in holding an infringement of a trade-mark or trade-name and endorsed the following significant language of such lower court, to wit:

> "A man may not use his own name to accomplish a fraud; neither can he use a synonym; neither can he use the name of the city where he resides, nor its nick-name, to accomplish a like purpose. It is always a question of fraud, but not necessarily of actual fraud. *The act, however innocent, is considered constructively fraudulent, if the result would tend to unfair trade, to confusion of goods, and to interference with the rights of another.*"

See, also, *Millington* v. *Fox*, 3 My. & C., 338; *Coffeen* v. *Brenton*, 4 McLean, 516.

The real question in this case, therefore, is not whether the defendants knew of complainant's trade-mark or trade-name, but whether the use by the defendants of a practically exact copy of such trade-mark is not constructively fraudulent because it tends to confusion of goods and to an unfair trading on reputation built up by the efforts and expenditure of another.

ALLEGED DEFENSE OF PRIOR ADOPTION NOT SUSTAINED BY EVIDENCE.

What appears to be an attempt to prove prior adoption of a similar word to complainant's "Pancreopepsine" is suggested in the deposition of James Turner and the deposition of Oscar O. Huyck, introduced in behalf of the defendants. Mr. Turner says that in 1878 he was engaged in the slaughtering and packing business in this city, and that he was a manufacturer of "Pancreatine" and "Pepsin," and on the 29th of June, 1878, wrote a letter to Mr. Joseph Dell, Cincinnati, Ohio, which is reprinted on pages 111 and 112, Record, in the postscript of which he suggests the use of the term "Pancro-Peptin" or "Pepsin." He further says that they got bottles made and labeled, and produces a label having the word "Pancro-Pepsin" thereon, which he says is the same label as they got printed at that time. He was asked when these labels were printed, with reference to the time he wrote Mr. Dell, and he answers: "I can't remember that very well, but I should say, right away." A guess of this kind as to the time is certainly not very satisfactory evidence. He next says that Dell & Clarke were to attend to the manufacturing and selling of the compound referred to on the label "Pancro-Pepsin," but they went into bankruptcy and that finished the whole negotiation, and the compound designated upon the label was never put upon the market or actually used in trade upon the goods. (See answers 20 to 22, page 113.) Based on such a state of facts, Mr. Turner could not claim prior adoption of the trade-mark, even if his date was earlier than that of William R. Warner, which it is not, for Warner's trade-mark was adopted in 1876 and Turner did not suggest his trade-mark until 1878.

In the case of *Koehler Mfg. Co.* v. *Beeshore,* where Justice Shiras delivered the opinion of the Court of Appeals for the Third Circuit, he held—

> "that the sale of a few dozen bottles with written labels pasted on the bottles, in the circumstances disclosed by the evidence, could not suffice to establish such an intentional use and appropriation of the words, as a trade-mark, as to warrant the interference of a court of equity."

If the sale of a few dozen bottles with the mark upon them would not suffice, how can it me maintained that where the labels were simply printed, and the compound never used in trade or put upon the market, that prior adoption results? Mr. Huyck testifies that in 1890, nine years ago, he entered the employ of the Searle & Hereth Company and called upon Mr. Joseph Dell to show him an article of their manufacture called "Pancro-Pepsin," and that the said Dell had a preparation of the same name in stock, and showed it to him, and that afterwards Mr. Dell took for him from the files the Turner letter heretofore referred to, and gave him the label to put in evidence. He does not state how long before this time Mr. Dell had articles thus labeled in stock, or how many packages of such article Mr. Dell had. Mr. Dell himself, although a resident of the city where the testimony was being taken —that is, Chicago—was not called as a witness. It is manifest that under the principles of the decision of the Court of Appeals, just alluded to, this testimony utterly fails to establish the adoption of the trade-mark.

But, as we have before suggested, even if this evidence did establish that the trade-mark was adopted by Mr. Turner or Mr. Dell some time in 1878, yet this date is not early enough to avail the defendants in this case. Mr. Warner, as we have seen by the evidence, adopted his trade-mark in 1876, and the registration obtained on such

trade-mark in the United States Patent Office, many years ago, confirms such evidence, for it contains the statement that the trade-mark was adopted in 1876. The evidence furthermore shows that Mr. Warner's preparation with his trade-mark "Pancreopepsine" was extensively sampled by his salesman Ramsey in 1878 throughout several cities.

The attempt of the defendants to show prior adoption by Turner or Dell is therefore an utter failure.

TRADE-MARK "PANCREOPEPSINE" NOT A DESCRIPTIVE TERM.

The principal burden of defendants' evidence is, and no doubt the principal allegation of the argument in behalf of appellee will be, that complainant's trade-mark "Pancreopepsine" is not practically and technically a trade-mark which can be legally protected, because such trade-mark is descriptive of the ingredients composing the remedy, and this makes it incapable of exclusive use by complainant as a trade-mark.

We may say at the outset that we freely admit that *if* the term "Pancreopepsine" is necessarily descriptive of the particular ingredients used in the remedy, it cannot be legally classed as a technical trade-mark, provided the legal proposition announced is supported by facts, or, in other words, provided it can be shown that the term "Pancreopepsine" is descriptive of the particular ingredients employed in the remedy. This is well settled legal doctrine and based upon sound logic. To use homely illustrations, a dealer in butter cannot by marking his goods "Pure Sweet Butter" prevent another dealer from marking his goods in the same way, because the words "pure sweet butter" are ordinary English words descriptive of the ingredients and quality and everyone has the

right to truthfully employ such descriptive terms. To illustrate by a case on the other side of this proposition, if a man applied to the article or butter which he put upon the market the name "Celaya Butter," having coined the word "Celaya" for the express purpose of getting a fanciful or arbitrary name to apply to his product, and this name was used by him under proper circumstances and a sufficient length of time to acquaint the public with it and indicate to them by the name the origin of the butter, then such man would have a trade-mark right to such name, and others would not be permitted to copy the name exactly or so closely as to mislead the public into believing that the name referred to same product of the first party. Intermediate of these two extreme cases which w have just illustrated, comes the majority of trade-mark cases, where the party adopts a word or mark which is not properly descriptive of the quality or ingredients of the product, nor so absolutely remote as to be incapable of suggesting the ingredients; while at the same time it cannot be positively held that the name definitely refers to any particular ingredients. In short, a term which is specifically descriptive cannot be adopted as a trade-mark, but a term which is suggestive and not definitely descriptive can be adopted as a trade-mark. This is the law, as we will show by the citation of a number of cases later on in this discussion; and the real question of fact now up for consideration is, whether the term "Pancreopepsine" is specifically descriptive (in which case it is not capable of protection as a trade-mark), or whether it is a coined word not definitely descriptive, but merely suggestive. We think we will be able to clearly show that the term "Pancreopepsine" is an arbitrary coined word not definitely descriptive, but, in fact, capable of suggesting a number of different substances, not one

of which can be certainly ascribed to it by either the purchaser or the pharmacist. In discussing this matter we will also refer to the defendants' term "Pancro-Pepsin," which rests upon practically the same ground.

We have already shown that the term "Pancreopepsine" originated with Mr. Warner in 1876. As the evidence demonstrates, the term was coined by Mr. Warner and first adopted by him. This of itself, we submit, ought to show that the term is not descriptive. Purely descriptive terms indicative of the ingredients or quality, like, for instance, "pure sweet butter," are not coined, but are found in the dictionaries and similarly adopted by every person who has occasion to use them as the exigency arises. On the other hand, the evidence shows that neither "Pancreopepsine" or "Pancro-Pepsin" were to be found in any dictionary, any text-book, any chemistry or other publication, prior to the time of Mr. Warner's adoption of the term. Of course, pepsin is a well-known medical substance, but neither the term "pancreo" nor "pancro," nor the compound names "Pancreopepsine" and "Pancro-Pepsin" are known medical or pharmaceutical terms. These are coined words. The testimony of Mr. Remick in regard to this matter is to be found on page 21 of the Record, and confirms the position which we have just indicated. Mr. Andrew J. Benson, a druggist of more than twenty years' experience, referring to the label "Pancro-Pepsin," testifies as follows:

> "Now, there is no such thing recognized in medicine as 'Pancro-Pepsin.' Pancreatine and Pepsin are regular medicinal preparations, but this is a foreign word. The same objection to Warner's preparation also. There is no such recognized medical preparation as 'Pancreopepsine.' It is a foreign word."

This man is a disinterested witness; and, in fact, he might be called a hostile witness, for we caught him in

the act of selling Searle & Hereth's "Pancro-Pepsin" to fill a prescription calling for Warner's "Pancreopepsine," and were obliged to subpoena him in order to get him to testify.

Professor Virgil Coblentz (who is, as is well known, one of the most eminent chemists and pharmacists in the United States, and has been for eight years lecturer on chemistry in the New York College of Pharmacy) testifies on this point. Referring to pages 127 and 128 of the Record, we quote the following questions and answers from Professor Coblentz' deposition:

> "Q. 40. Have you been able to find in the United States Pharmacopoeia, The United States Dispensatory, or any chemical, pharmaceutical, or medical work, either of the names 'Pancreopepsine' or 'Pancro-Pepsin' or the prefix thereto?
>
> "A. I have searched the literature, both ancient and modern, foreign and domestic, and fail to find any words which have the least resemblance to the above mentioned.
>
> "Q. 41. Then, on the whole, do you conclude that the terms 'Pancreopepsine' and 'Pancro-Pepsin' are descriptive titles or fanciful trade-names?
>
> "A. I consider that the above terms are simply fanciful titles, leaving one to infer their medicinal properties."

The defendants called Prof. Walter F. Haines, of Chicago, as an expert, and he made a most elaborate attempt to demonstrate that the words "Pancreopepsine' and "Pancro-Pepsin" were descriptive; but in the very beginning of his cross-examination he was obliged to corroborate the testimony of Professor Coblentz and others just referred to. We quote from page 63 of the Record the questions and answers in Professor Haines' deposition above referred to, to wit:

> "X-Q. 16. Do you find in the United States

Pharmacopoeia and Dispensatory either the name 'Pancreopepsine' or 'Pancro-Pepsin' applied to any medicinal preparation?

"A. I do not.

"X-Q. 17. Do you find either of these names in any medical dictionary with which you are acquainted, or any works of materia medica?

"A. I have not found them in any medical dictionary or work of materia medica that I have consulted.

"X-Q. 18. Did you ever find or observe either the word 'Pancreo' or 'Pancro' in any medical or pharmaceutical text-book, or in any recognized dictionary, whether medical or otherwise?

"A. I cannot state with certainty whether on any occasion I have ever seen the word 'Pancreo' or 'Pancro' in a medical or pharmaceutical text-book, or any recognized dictionary. I may say, however, that as far as I now remember, I have not."

And finally, Mr. Dyrenforth, counsel for defendants, makes the following admission upon the record:

"By Mr. Dyrenforth: If it will save cross-examination upon the matter, which I regard as wholly immaterial, I am perfectly willing to admit on the record that the specific forms 'Pancreopepsine' and 'Pancro-Pepsin' were not employed before the year 1876." (See page 64, Record.)

Thus the evidence demonstrates that the terms "Pancreopepsine" and "Pancro-Pepsin" were absolutely new in 1876, when Mr. Warner first adopted his trade-mark. If Mr. Warner had called his medicine "Pancreatine-Pepsin," and it had only these two ingredients in it, then his name or trade-mark would be purely descriptive; but this is far from what he has done. He has adopted a coined prefix never before known or used, to wit, "Pancreo," and to that he has joined the suffix "pepsine," and thus made the compound word "Pancreopepsine" which at the

time of its adoption was a purely arbitrary name which had never before been known or used by any person.

And it is furthermore shown by the evidence that it is not a fact, as defendants' expert, Professor Haines, alleges that "Pancreopepsine" contains as its principal ingredients pancreatine and pepsin.

Mr. Warner says that the chief ingredients of his preparation are pepsin, muriatic, lactic and phosphoric acids, and pancreatine, and that pancreatine is not contained in as great quantities as some of the other ingredients. (See answers 22 and 24, page 35, Record.) Now, does the prefix "Pancreo" describe muriatic acid, or lactic acid, or phosphoric acid? And yet each of these are contained in the preparation, and some of them in greater proportions than pancreatine. How then can it be argued that "Pancreopepsine" is descriptive of the leading ingredients, when, as a matter of fact, it cannot possibly suggest some of the leading ingredients which are more prominent even than pancreatine? The very expert whom defendants called to prove their proposition—Prof. Haines—admits that he never analyzed complainant's liquid "Pancreopepsine," nor the defendants' preparation known as "Pancro-Pepsin;" how absurd, therefore, it is for him to hold that pancreatine is the leading ingredient. This alone suffices to condemn his entire line of reasoning.

One of the defendants, Frank S. Hereth (the chemist of the firm), makes an admission which we think, when carefully considered, demonstrates conclusively that he did not believe the statement made by him and his experts to the effect that the term "Pancro-Pepsin" is descriptive of the principal ingredients. If the term "Pancro-Pepsin" on the label of a bottle is accurately descriptive of the principal ingredients, no other description is needed on the bottle; and yet on the bottles of liquid "Pancro-Pep-

sin" as sent to the trade by defendants there is in addition to the title "Pancro-Pepsin" the following description or definition:

> " 'Pancro-Pepsin' is composed of the essential elements concerned in the digestion of food, viz., pepsin, pancreatine, ptyalin, lactic and hydrochloric acids."

In question 78, page 53, we asked this defendant why he put this description, containing a list of the ingredients, on the labels of his bottles, and his answer was as follows:

> " In order that physicians may be informed as to the composition of the remedies, and in order that druggists may intelligently dispense them."

Truly a remarkable answer! The composition of this remedy, "Pancro-Pepsin," is therefore, *not sufficiently indicated by the name,* so that physicians may be informed, or so that druggists may intelligently dispense it! What does the allegation of the defendants, that this title is descriptive, mean, if it is true as Mr. Hereth testifies that in order that physicians may be informed as to the composition of the remedy, and that druggists may intelligently dispense it, it is necessary to put a list of the ingredients on the label in addition to the name? Here is a notable illustration of the old maxim that "actions speak louder than words." They say that the title "Pancro-Pepsin" is accurately descriptive, but when they come to distribute the goods to physicians and druggists they are not satisfied with the description given in the title, and admit that it is necessary to distinctly define the composition of the remedy by giving a list of the medicines contained therein. Mr. Hereth well knew that neither physicians nor druggists would know the composition of the remedy from the name! He well knew that he must give both physicians and druggists further information on the bottle! He well

knew that it was not safe for him to rely on the name "Pancro-Pepsin" to give this information; that, in short, *that name was not descriptive*, and so he supplemented the name by a statement of what the name meant, or, in other words, by a list of the medicines contained in the compound! And yet these defendants and their counsel had the effrontery to come into a court of justice, with this act disclosed on the record, and endeavor to hoodwink the court into believing that the name "Pancro-Pepsin" *by itself* is definitely descriptive!

We will now call attention to a decision in the High Courts of Justice, Chancery Division, in England, which is identical with the present case. We refer to the case of *Carnrick, Kidder & Co.* v. *Morson & Son* (reported in 1877 Law Journal Notes on Cases, p. 71; also in Sebastian on Trade-Marks); and *Same* v. *Mackey, Seller & Co.*, decided on the 22nd of March, 1877. In that case, Messrs. Carnrick, Kidder & Company, of New York, had adopted, as a name for a digestive agent containing pancreatine, lactic acid, pepsin and certain other ingredients, the term "Lactopeptine." The defendants used the term "Lactopepsine." The defense was that "Lactopeptine" or "Lactopepsine" were purely descriptive terms referring directly to pepsin and to an abbreviation of the term "lactic acid," which was another ingredient, such abbreviation being made according to well-known rules of nomenclature. It was admitted, however, that the compound word "Lactopeptine" or "Lactopepsine" was not to be found in any pharmacopoeia or medical dictionary, and had not been known or used until the plaintiffs adopted it. The Vice-Chancellor held that there was an infringement, and that the word "Lactopeptine" was a valid trade-mark, and in the course of his opinion used the following language:

> "The history of the case is, that the plaintiffs having invented a compound—Mr. Rogers calls it a drug, I say a compound—give to it a purely fanciful name, and it does not make it the less a fanciful name because lacto is in it and pepsin is in it, because 'Lactopeptine' does not describe any drug. There is no such thing to be found in the Pharmacopœia. . . . When you look at the formula which is printed upon the bottle containing what is called 'Lactopepsine' you find a variety of ingredients, sugar or milk, pancreatine, and other things which I need not mention, and so far from being a drug well known, it is nothing like a drug, and it is a composition to which the man who compounds it chooses to give the appellation and descriptive trade-mark and character of 'Lactopepsine' or 'Lactopeptine.'"

It is hard to conceive of a more closely analogous case than the one just cited. The court held "Lactopeptine" a valid trade-mark, notwithstanding the presence of lactic acid and pepsin in the compound. If that decision was right, why is not "Pancreopepsine" a valid trade-mark? In fact, it looks very much as if the defendants in this case were driven to adopt complainant's trade-mark "Pancreopepsine," or its colorable imitation "Pancro-Pepsin," because they knew the courts had decided that they could not use the trade-mark "Lactopepsine." Our basis for this statement is the depositions of Turner and Huyck filed in behalf of defendants. It appears by the letter written by Turner to Mr. Joseph Dell in 1878 that Turner knew that "Lactopeptine" was registered and had been sustained in an English court, and so wrote to Mr. Joseph Dell, and then suggested to Mr. Dell that if they adopted a similar word they would be liable to be beaten in a similar suit by the same parties, and therefore suggested to Mr. Dell the word "Pancro-Pepsin." This will be found in the letter reprinted on pages 111 and 112 of the Rec-

ord. Next we find that Searle & Hereth's (the defendants) salesman Huyck testifies that nine years before he gave his testimony (January, 1899) he called on Dell and was told that he (Dell) had an article in stock called "Pancro-Pepsin." This would fix the call as about January, 1890, and as Searle & Hereth went into business in 1889 or 1890, this evidence would make it extremely probable that Searle & Hereth adopted the name "Pancro-Pepsin" to indicate the same goods which had been before called "Lactopeptine," but which latter name the court had decided could not be imitated. They now make the same defense that the defendants did in the case of "Lactopeptine," and we submit, as the facts are just the same, the ruling of the court should be just the same. We may add that it also appears in the English case that the defendants attempted to distinguish their use by stating that their bottles were marked with their own name as well as with the title "Lactopepsine," but the court stated that the ordinary observer would look at the name of the medicine and not at the name of the manufacturer. Likwise in this case, Searle & Hereth have introduced similar evidence, which is equally lacking in force.

In view of the above considerations, we submit it is perfectly clear from the evidence, and especially the oral admissions, and the acts of the defendants amounting to admissions, and just above alluded to, that neither "Pancreopepsine" nor "Pancro-Pepsin" are, when properly considered, descriptive names.

Inasmuch, however, as defendants expert witness, Prof. Haines, has devoted many pages of the record to an attempt to show that "pancreo" would be understood by chemists and pharmacists to refer to pancreatine, and could by no possibility refer to anything else, we feel that

it is probably better that we should follow him and expose his fallacy as to the facts upon which he bases his assumption, even though, in view of the other facts and the law to which we have referred, the assumption itself would be immaterial and irrelevant.

In other words, our position, is, first, that the prefix "pancreo" and the compound word "Pancreopepsine" are arbitrary and fanciful, and, therefore, being first adopted by Mr. Warner, are valid trade-marks, and not, properly considered, descriptive, even if we assume the allegation of Prof. Haines that the prefix "pancreo" suggests the ingredient "pancreatin;" second, that the assumption of Prof. Haines is not true, as a matter of fact, because "pancreo" and "pancro" may just as well refer to, and be abbreviated from, other words as from "pancreatine."

The very complicated nature of Prof. Haines' explanations serves to cast a doubt upon his reasoning, for if a word is accurately descriptive it is usually apparent on the face of it and does not need dozens of pages of printed matter to prove it.

Prof. Haines, the defendants' expert, testifies that a time-honored method of naming compounds of two or more substances is to use a term descriptive of the constituents, and that among the many methods of carrying out this principle is that of uniting the names of the principal ingredients, and, for the purpose of brevity and euphony, eliding a part of the name of one of the constituents and terminating that name with the letter "o." He cites many illustrative words, such as "Nitro-Glycerin," composed of nitric acid and glycerin; "Nitro-Benzine," obtained from nitric acid and benzine; "Oleomargerine," supposed to be composed of oleine and margerine, etc. He further says that from the above it is very clear, when in chemistry or pharmacy we find a compound word

like "Pancro-Pepsin," that it is inevitable that we should consider pancreatin and pepsin as the principal component ports of the material contained therein. He makes the same statement with regard to the complainant's term "Pancreopepsine." He further says there is no other medical substance whose name could "possibly be tortured either into 'pancreo' or 'pancro,' except 'pancreatine.'" Now this reasoning is plausible, but far from being sound. In the first place, Prof. Haines, in illustrating by the words "Nitro-Glycerin," "Nitro-Benzine" and "Oleomargerine," has made no attempt to show whether these words were originally trade-marks or not, or whether any person ever attempted to make trade-marks out of them by adopting them exclusively for a number of years, as did Mr. Warner with his name and preparation. Again, Prof. Haines has not used illustrations which are comparable to the name in question. "Nitro" can be derived from "nitric" by the change of but two letters and no change of syllables. "Pancreo" or "pancro" can be derived from "pancreatine" only by leaving off two syllables, that is, "a-tine." So that the resemblance in the latter case is very much less than in the illustrated cases given by Prof. Haines.

Again, Prof. Haines falls into a fallacy in his reasoning in comparing his illustrations with the name now in question, in that he absolutely knew what "Nitro-Glycerin" was made of, but, as we have before seen, he, in cross-examination, stated that he never made an analysis of either the substance called "Pancreopepsine" or the substance called "Pancro-Pepsin," and did not know, in fact, of what it was composed. Perhaps if Mr. Haines had read Mr. Warner's deposition and ascertained that "Pancreopepsine" contained muriatic acid and lactic acid in greater proportions than it did pancreatine, he might

not have concluded that "pancreo" was descriptive of the leading ingredients.

However, let us follow Prof. Haines further in his reasoning. As we have just observed, he says that there is "no other medical substance whose name could possibly be tortured either into 'pancreo' or 'pancro,' except pancreatine." Here is where Prof. Haines shows himself wofully ignorant of the facts. In cross-question 98 he was asked if he was acquainted with the term "pancratium, and he said he was not. In cross-question 101 he was asked if such a word as "pancratium" is to be found in medicine, the prefix "pancro" might properly be derived from it, or from the word "pancratic." He answered:

> "That would depend upon whether these words referred to substances used in medicine and which could be compounded or mixed with pepsin for remedial use. In that case I should say that they might give rise to the prefix 'Pancro,' but not otherwise."

Prof. Coblentz, the eminent chemist who has been for many years Professor of Chemistry and Pharmacy in the New York College of Pharmacy, testifies as follows:

> "The term 'Pancratium' is an old term of designation for the squill. If a preparation should contain an extract of this drug, there would be no rule which would prevent us from employing any portion of the term 'Pancratium' as a prefix, commercial titles being designated with the view to simplicity and euphony."

He further testifies, in answer to question 34, as follows:

> "I before said that it is a well known fact that 'pancratium' refers to squills, and that squill, while administered in small doses, acts, by virtue of its irritating properties, as a digestive stimulant, causing

a profuse secretion from those glands which secrete the digestive fluid. *I have dispensed and seen various prescriptions in which squill has been used in conjunction with digestive ferments.*"

This is confirmed in Thomas' Medical Dictionary of 1834, which specifically refers to a species of pancratium as a medical plant which has medicinal properties resembling that of squill. Again it is confirmed by Hooper's Medical Dictionary of 1834, which says that it is a plant which is sometimes called "scilla" or "squill," used in many diseases, and amongst other things, "esteemed as a stimulant to the stomach." Again, in Dunglison's Dictionary, revised in 1868, " 'Pancratium' is said to be a name applied to a plant which was considered all-powerful."

As we have seen, Prof Haines admits that this word, if it referred to a substance used in medicine which could be compounded for remedial use with pepsin, might give rise to the prefix "pancro;" and as we have seen by the eminent medical authorities which we have cited, and also the testimony of Prof. Coblentz, this word "pancratium" does define a plant which is used as a medicine to stimulate the stomach, and, as Prof. Coblentz says, has been used in conjunction with digestive ferments. Therefore, it follows that Prof. Haines is convicted by his own admission, coupled with the information given by the authorities, of holding that the prefix "pancro" or "pancreo" may as well be derived from "pancratium" as "pancreatine," and consequently his whole argument falls to the ground because it is based upon the theory that these prefixes refer to pancreatine alone, and, as he expresses it, cannot possibly be tortured from any other medicinal word. It is of course self-evident that if a person who sees the prefix "pancreo" or "pancro" cannot determine

whether it refers to pancratium or some other substance, then such prefix cannot be descriptive. We will cite some authorities on this proposition a little later, although it would seem unnecessary.

We might also refer to another meaning of the word "pancratium," which is equally serviceable in this connection. A large number of authorities, including those we have cited, speak of "pancratium" meaning "powerful" or "all-powerful." This is manifestly a meaning derived from the plant, because the plant was not only used as a stimulant for the stomach, but also for many other purposes in medicine. But this meaning of "all-powerful" might well be associated with the term "pepsine," and then "Pancreopepsine," while it would not be descriptive, would suggest an all-powerful pepsin. This is particularly to be considered, because Mr. Warner states in his deposition, in answer to cross-question 23, that while saccharated pepsin was used in the beginning, now a more perfect and stronger pepsin known as "scale pepsin," 3,000 test, is employed. He might very well, therefore, have had in his mind at the time he coined this new name "Pancreopepsine" the suggestion of an all-powerful pepsin. Of course he could not use in a trade-mark the words "all-powerful," but he could coin an expression that was derived from a word signifying "all-powerful," and it is very likely that that is what suggested the prefix "pancreo" to him; although of course we have not gone into that, for it is not necessary to prove why the prefix was adopted. It is a little remarkeble that Prof. Haines, in re-direct examination, while he admits what he did not know before—that pancratium is a substance recognized by medical dictionaries—yet objects that it is practically obsolete to-day. So much the better. Mr. Warner's name was adopted twenty-four years ago, and not to-day.

The word "pancrene," Prof. Haines admits in re-direct examination, is an old word for "pancreas," and certainly the prefix "pancreo" might be derived from "pancrene" much more readily than from "pancreatine." This again disproves Prof. Haines' allegation made in his direct examination that the prefix "pancreo" could not possibly be tortured from any other word than "pancreatine."

Likewise, the prefix "pancreo" or "pancro" might be derived from the organ of the body called "pancreas," and this Prof. Haines admits in his cross-examination, but excuses himself by saying that in such case the term would be equally descriptive of the digestive substance present in the organ or gland. This, we submit, is pretty far-fetched. It certainly can hardly be contended, and in any event is shown by the authorities to be untrue, that the organ of the body called the "pancreas" contains only pancreatine. This organ contains a number of substances, and in adopting the prefix "pancreo" it might have been the intention to have indicated or suggested merely that pepsin had combined with it something derived from the pancreas. This certainly could not be called descriptive of the substance itself, for it would not be at all certain which of the substances was intended, and in order to make the term descriptive, under the trade-mark law, it must have a definite and distinct descriptive function, as we will hereafter show by the authorities. If it may refer to either of several substances, then it is not descriptive under the law.

There are a large number of other words from which either the prefix "pancreo" of "pancro" could be readily derived, "without torturing those words" (to use complainant's expert's language) any more than the word "pancreatine" is tortured by having these prefixes ascribed to it as a derivation. We will not attempt to

mention all of them. A few will suffice to illustrate the principle for which we are contending, namely, that a number of words might readily serve as the derivation of these prefixes.

"Pancratic" is a word found in many chemical dictionaries, and means "all-powerful" or "very potent." We may cite as an authority Dunglison's Dictionary of 1893. Certainly "pancratic" is as close to these prefixes "pancreo" and "pancro" as is "pancreatine."

"Pancreazymose" is defined as one of the ferments of the pancreas by Foster's Medical Dictionary, Volume 29, page 368. It is just as easy to elide "azymose" from this word as "atine" from "pancreatine," and yet this is an entirely different word, and according to Prof. Haines has an entirely different meaning, for Prof. Haines declares that "pancreatine" means a combination of all the three ferments, whereas the word just referred to only designates one.

"Pancreatogen" is defined by Gould's Medical Dictionary of 1894 as a nutritive element capable of being changed into pancreatine. So we see that while it may be a foundation for it, it is not the same thing, and yet these prefixes could be derived as readily from it as from the latter term.

"Pancreatoid" and "pancreatonicas" are each defined by Foster's Medical Dictionary as a tumor of or resembling the pancreas. It is evident that the prefixes "pancreo" and "pancro" might easily be derived from these words by as simple a change as from the word "pancreatine."

It is useless to multiply instances when they are so numerous.

We will next attack the position taken by defendants' expert, Prof. Haines, as to the meaning or definition of

the term "pancreatine." Prof. Haines asserts that pancreatine is the active principle of the organ called the pancreas, and *always* includes *the combination of the three ferments* found in the pancreas, to wit, steapsin, trypsin and amylopsin. He argues from this premise that if the prefixes "pancreo" and "pancro" undoubtedly refer to no other substance than pancreatine, and pancreatine is a fixed or definite substance, never varying in its constituents, then these prefixes are necessarily descriptive. We will now endeavor to show that even in this last position of Prof. Haines his premise is fallacious and untrue. There are undoubtedly to be found in the pancreas the three ferments (steapsin, trypsin and amylopsin) just mentioned. All medical and chemical authorities agree upon this. Prof. Haines, however, relies upon the last edition of the United States Pharmacopoeia, which gives the following definition:

> "PANCREATIN. A mixture of enzynes naturally existing in the pancreas of warm-blooded animals; and is obtained from the fresh pancreas of the hog."

Now it is true that if this was the only medical authority in the world Prof. Haines might have some foundation for his definition, but unfortunately for him it is not. Complainant's expert, Prof. Coblentz, entirely disagrees with Prof. Haines, and also cites authorities, and many of them. Prof. Coblentz testifies that there is no such term as "pancreatine" known to physiological chemistry, but that term is merely a commercial name for various proprietary preparations, and the various ferments found in the pancreatic juice, and sometimes is applied to the juice itself. He cites the United States Dispensary, 17th edition, of 1894, which gives the following definition:

> "The term 'pancreatine' has been variously used

for *many different preparations* from the pancreatic gland, and has long been popularly employed for the purpose of distinguishing preparations more or less of the nature of extracts from the gland."

He testifies that his authority is more reliable than the United States Pharmacopoeia which Prof. Haines cites, and amongst chemists, pharmacists and physicians the United States Dispensary has always been given the preference. His reasons he gives in answer 23, page 199, Record.

Prof. Coblentz also cites the eminent authority, Standard Dictionary of Funk & Wagnalls, in which is the following definition:

"PANCREATINE. A proteid compound contained in the pancreas, probably *one* of the active ferments of the pancreatic juice."

He also cites the standard works of reference in Europe, such as Hager Handbuch der Pharmaceitischen Praxis, 1894, which says:

"'Kuehne' names the albumen digesting ferment in pancreatic juice, 'trypsin.' Heidenhain calls this same ferment 'pancreatin.'"

Thus we see this celebrated German authority speaks of *one* of the ferments as "pancreatin" instead of all of them.

Again, he cites the most famous German chemistry, Fehling's Hanworterbuch der Chemie, 1886, which gives the following title: "Trypsin (pancreatine)," This shows that this German chemistry uses the term "pancreatine" as a synonym for *one* of the ferments, which is by others known as "trypsin."

Again, the well-known chemistry by Prof. Ladenburg, Vol. 4, page 116, states: "Trypsin (Frueher Pankreatin)," which names that "trypsin" was formerly known as "pancreatine."

Thus we see that three German authorities speak of "pancreatin" as another name for one of the ferments called "trypsin," while Prof. Haines insists that it does not designate one of the ferments, but necessarily refers to a combination of them all.

We ask particular attention to Prof. Coblentz' answering deposition, and especially to pages 192 to 201, Record. In Webster's Unabridged Dictionary the following definition is given:

> "PANCREATINE. *One of the digestive ferments* of the pancreatic juice; also a preparation containing such a ferment, made from the pancreas of animals, and used in medicine as an aid to digestion.
>
> "By some the term 'pancreatine' is restricted to the amylolytic ferment of the pancreatic juice. By others, it is applied to trypsin. And by still others, to steapsin."

Prof. Coblentz says that Webster's Dictionary is regarded as a reliable authority in regard to such matters, for the most eminent chemists in the United States were employed in defining the chemical terms. And yet Webster agrees with the United States Dispensatory and the three German authorities cited, and disagrees with Prof. Haines and his single authority, for Webster says that pancreatine is one of the ferments, and Prof. Haines says it is not, but is a combination of all three.

Dunglison's Dictionary of 1874, which was a chemical dictionary of great repute at that date, states as follows:

> "The pancreas secretes the pancreatic juice. When this juice is mixed with amylaceous matters it converts them into dextrine and glucose. Its great use appears, however, to be to emulsify fatty matters, by virtue of a peculiar albuminoid principle—pancreatin —which it contains."

The United States Dispensatory before referred to also

said that the emulsifying property of the pancreatic juice was "a peculiar form of casein or albumen," and this was independent of the three ferments.

Prof. Coblentz, in his answer 20, compares these two authorities, and says they perfectly agree on this point, but disagree with Prof. Haines, because Prof. Haines had said that "pancreatine" was a mixture of the three ferments; while Dunglison says that the principle of the pancreatic juice which emulsifies fats is "pancreatine," which is an albuminoid principle; and the United States Dispensatory says that this is true, and that this albuminoid principle is independent of the three ferments, thus contradicting Prof. Haines, who says that "pancreatine" is a combination of the three ferments.

Prof. Coblentz testifies that Dunglison's Dictionary is a most excellent authority. (See answer 43.)

Prof. Haines, defendants' expert, was asked to give a list of some of the physiologies which he understood to be most reliable, and amongst others he gave Dalton's Physiology. Now in Dalton's Physiology of 1874, page 168, it is stated that the pancreatic juice contains three substances belonging to the class of ferments "which exert three distinct actions on alimentary substances, namely, a transforming action on starch, a digestive action on coagulated albumin, and a partial acidifying action on fats." He further states that the first of these three substances—"the so-called pancreatine—is a diastatic ferment; that is, it has the power, like vegetable diastase, of transforming starch into glucose." He further states that the second ferment "known as 'trypsin' is that which causes the solution of albuminoid matters." Thus it will be seen that Dalton also agrees with our theory and contradicts Prof. Haines, for he calls one of

the ferments "pancreatine" (to wit, the one that transforms strach into sugar or glucose).

We have now shown that opposed to Prof. Haines and his one authority, the United States Pharmacopœia, is Prof. Coblentz, United States Dispensatory, Standard Dictionary of Funk & Wagnalls, Webster's latest unabridged dictionary, three celebrated German dictionaries and chemistries, Dunglison's well-known dictionary (chemical), Dalton's Physiology (recognized as a standard even by Prof. Haines), and many others. The weight of authority is, therefore, clearly with our theory that pancreatine is not a distinct, definite substance, combining the three ferments, but that "pancreatine" is a name applied indifferently and by various authorities to different substances, and Prof. Haines' authority simply seems to emphasize our position, for if the United States Pharmacopœia says pancreatine is a mixture of ferments, and the United States Dispensatory says it is any one of many preparations, and Dalton's Physiology says it is one ferment (to wit, the starch-digesting ferment), and the three German authorities say it is trypsin (the albuminoid form of digesting ferment), and Funk & Wagnalls' Dictionary and Webster's Dictionary say it is a name indifferently applied to any one of the three ferments, then it is perfectly clear that the authorities are so irreconcilable as to which particular or definite substance the term "pancreatine" does apply that even if Prof. Haines' theory that the prefixes "pancreo" and "pancro" are necessarily derived from this term is correct, yet they are not descriptive, for the term itself is applied indifferently by the authorities to different substances, and the user who sees the term cannot tell to which substance reference is made by the use of the term.

We will follow Prof. Haines, the defendants' expert, throughout every step of his complicated system of reasoning, because each step is plainly based upon false premises, and therefore, although it would seem almost a waste of time, we will proceed to his next allegation and show that that is equally without basis or fact.

Prof. Haines having alleged that "pancreatine" is a name applied to a combination of all three of the ferments, and being met with authorities (some of which we have cited in this brief) to the effect that it was also applied indiscriminately to either one of the ferments, that is, to trypsin, steapsin or amylopsin, attempted to take refuge in the statement that this was impossible because these three ferments found in the pancreas could not be separated. We will now show that in this statement he was also wrong, both from the chemist's standpoint and from the pharmacist's standpoint.

First, from the chemist's standpoint. The ferment trypsin, derived from the pancreas, was isolated by Danielessky in 1862. Steapsin was isolated by Paschulkin in 1873. Amylopsin was isolated by Von Wittich in 1879. The authorities for these statements are numerous and varied. Probably the most celebrated work on chemistry known to the world is Beilstein's Organische Chemie, and this book distinctly announces the proposition above put forward. Landenburg's Chemistry is also well recognized as eminent authority, and this likewise endorses the proposition. (See Vol. 4 of 1887.) Prof. Coblentz, of the New York College of Pharmacy, gives his endorsement to the statements. (See answer 17, page 122, Record.) In his answer to cross-question 202 Prof. Coblentz testifies that Prof. Beilstein not only refers to the fact that pure trypsin can be isolated, but gives a method for the preparation of it, and that he (Prof. Coblentz),

following this method, found that he could procure pure trypsin. Not only this, but Prof. Coblentz designates certain manufacturers who habitually isolate the three ferments, and introduces samples of their product.

This brings us to a demonstration, from the pharmacist's standpoint, that the three ferments may be separated, and are in fact put upon the market as separate substances. Attention is called to the exhibit introduced by complainant and marked "Complainant's Exhibit Fairchild's Trypsin, otherwise called Pancreatine." (See page 156, Record, for testimony regarding the same.) Fairchild Brothers & Foster are also shown to likewise separate and put upon the market as a distinct product amylopsin. And Prof. Coblentz refers to the fact that he has frequently seen specimens of trypsin and amylopsin of foreign manufacture.

A number of vials of material were introduced in evidence as exhibits to show that from the pharmacist's standpoint the term "pancreatine" as used on the market referred to substances composed of different ferments. For instance, the exhibit "Reed's Pancreatine" was chemically tested and found to contain steapsin only and neither of the other ferments, because the tests show that it only had emulsifying properties, which is recognized as the result of steapsin.

Again, the exhibit "Savory & Moore's Pancreatine" was tested by Prof. Coblentz and found to have no albumen digesting property, which shows that the ferment "trypsin" was absent from its composition.

On the other hand, the specimen of Cudahy's product is claimed to contain the product of all three of the ferments, which shows how widely different the products found on the market, and labeled by different manufac-

turers as "Pancreatine," are in regard to the substances which they contain.

At this point it may be well to briefly refer to what counsel for defendants seem to think important in their behalf, to wit, what Prof. Coblentz, in an elementary treatise entitled "Hand Book of Pharmacy," written by himself, refers in the index to a pancreatine emulsion, and specifies that as an emulsion pancreatine is a mixture of natural ferments. This statement, counsel for defendants says, involves Prof. Coblentz in a contradiction, or rather, is a contradiction of his testimony. When fairly considered, the attack is absurd. In the first place, the definition given by Prof. Coblentz in his elementary work suggests that it is a mixture of natural ferments, but it does not say that it is a mixture of *all* the ferments. On the contrary, the point is that *when used as an emulsifying agent* it is a mixture of natural ferments, which is undoubtedly true. We have seen by various authorities that the term is sometimes used to refer to only one of the ferments, and sometimes to another and different ferment, and sometimes to a mixture of two of them, and sometimes to a mixture of all of them. Of course, in each case the number of ferments contained depends upon the use to which the substance is to be applied. If it is merely to convert starch into sugar, pancreatine need only be one of the ferments, to wit, amylopsin. If it is to change or act upon albumen, pancreatine may be either trypsin, or it may be trypsin and a fourth substance which none of the books name, but several of them refer to; or, in other words, a mixture of these two. The United States Dispensatory says this fourth substance is independent of the three ferments. In the same way, if it is the emulsifying action which is desired, pancreatine would be composed of steapsin, or a mixture of steapsin and trypsin. There is

plainly, therefore, no contradiction of Prof. Coblentz' testimony in the statement contained in his hand-book. But even if there was it would make no difference. As Prof. Coblentz explains, that was a mere elementary treatise which did not attempt to go into details, and he supplied these details in his lectures as he does in his testimony. (See answer to cross-questions 196 to 200, pages 151 and 152, Record.)

By way of a brief recapitulation, we will therefore refer to the foregoing discussion as demonstrating that neither "Pancreopepsine" nor "Pancro-Pepsin" are descriptive terms, for the following reasons, to wit:

1. Neither these terms nor their prefixes were to be found in any dictionary, text-book, or chemical or pharmaceutical publication prior to the time when Mr. Warner adopted the term in 1876, but the words are coined terms applied to a new compound.

2. There are a number of ingredients in the compound —such as lactic acid, muriatic acid, ptyalin—which no syllable of the term "Pancreopepsine" or "Pancro-Pepsin" even suggest; and the chemist defendant, Prof. Hereth, admits that, in addition to placing the title "Pancro-Pepsin" on the bottles, he was forced to also mention each of the substances composing the medicine, *in order* that physicians and pharmacists might intelligently prescribe and dispense it.

3. The prefixes "pancreo" and "pancro" are arbitrary and fanciful, and may as readily be derived from other words as from "pancreatine," as for instance, from "pancratium," "pancrene," "pancreas," "pancratic," "pancreazymose," "pancreatogen," "pancreatoid," etc.

4. The prefixes "pancreo" and "pancro," even if assumed to be derived from "pancreatine" (as alleged by Prof. Haines for the defense), are yet not descriptive, be-

cause "pancreatine" is not a distinct, definite substance of fixed constituents, but widely varies in its composition. It sometimes refers to a mixture of the three ferments, steapsin, trypsin and amylopsin; at other times it is a name given steapsin alone; yet again, the term is applied to amylopsin alone; often it designates only trypsin; and finally, it is a name given by Dalton's Physiology and other authorities to an albuminoid principle which the United States Dispensatory says is independent of any of the ferments.

The above variation in composition is from the chemist's standpoint, and in pharmacy the name is indiscriminately applied to a variety of extracts put upon the market by different manufacturers, as is proved by the United States Dispensatory and by the samples of several of these manufacturers which have been introduced in evidence.

A NAME MERELY SUGGESTIVE AND NOT DEFINITELY DESCRIPTIVE IS A VALID TRADE-MARK UNDER THE LAW.

We have in the earlier portion of this brief announced this proposition as a rule of law, but we will now refer to the reasons which support this rule, and to the authorities sustaining it. First, let us consider why a word which is purely descriptive cannot be monopolized as a trade-mark by a particular individual, firm or corporation. There are a number of different things which the public at large have the right to use, and which right is inalienable. For instance, the air we breathe is common property of necessity, and no one would have a right to monopolize it for himself or his associates. Again, the language we employ to communicate with each other is common property of necessity, and no one would have the right either to monopolize the right to use the English

language as a whole or some particular part of it. The reason supporting these illustrations is self-evident. If one particular individual or firm could monopolize the air we breathe, he would be robbing the rest of mankind of a prior right belonging to them. If one could monopolize the English language, or a particular word in such language, used in its ordinary sense, he would be robbing the rest of mankind of a prior right to the use of that language, or that word, which robbery would, of course, be against public policy and essential justice. It is upon this principle that the courts hold that a word which is purely descriptive cannot be monopolized as a trade-mark. The adjectives "pure" and "sweet" have a certain definite meaning, and are to be found in any recognized English dictionary as part of our common vocabulary, and the word "butter" is equally well known and recognized by lexicographers. And a man who attempted to sell butter to the trade under the designation of "pure sweet butter," while he would be permitted so to do, if it was a correct designation, yet manifestly he could not prevent others from using the same appellation, for they, as well as he, had the right to employ the well-known noun to indicate the substance, and the well-known qualifying adjectives to indicate the character of the substance, and to permit such a man to call these words a trade-mark, and thus monopolize the use of the words, would be to rob the public of its right to use well-known English words in their usual significance. It would be, in fact, to permit a subtraction from the public domain by an individual. This is the reason why descriptive terms cannot be utilized as trade-marks.

On the other hand, if a person, firm or corporation employs a designation to identify the particular goods he sells, which designation is not a word found in the

public domain, but is an expression coined by him, then he subtracts nothing from the public, and the reason for objecting to the monopoly of the term he employs is wanting. The fact that the term may be suggestive of the substance to which it refers is commendable rather than objectionable, provided such expression is not descriptive, for in this event nothing is taken from the public which they had before, and a term is added which, after the monopoly expires, will be serviceable, as were other designations when adopted. There is no logical basis for objecting to a man coining a word and applying it as a designation to a particular article which he manufactures, for the reason for prohibiting the exclusive use of descriptive terms by a single individual to the detriment of the public is absolutely lacking. It will be found, therefore, that the authorities recognize the distinction between a purely descriptive term and an arbitrary or coined expression which may or may not be suggestive, holding in the case of the descriptive term that it is not permissible to monopolize its use, and in the case of the suggestive term that it is allowable to exclusively utilize it by the originator or first adopter.

The decision of the High Court of Chancery in England in the case of *Carnrick, Kidder & Co.* v. *Morson & Son* (a copy of which decision duly authenticated will be produced at the hearing), cited in an earlier portion of this brief, and by which "Lactopepsin" was declared to be a valid trade-mark, although the preparation given this name included pepsin and lactic acid, is about as exactly opposite an authority as can be imagined, and deserves, therefore, to be first mentioned in this chapter. For a full discussion of it we refer to the former pages of the argument.

Another exceedingly opposite decision serving to illus-

trate the principle above announced is the Bromo-Caffeine case. The Supreme Court of the State of New York decided that "Bromo-Caffeine" was not a proper trade-mark, because "Bromo" was definitely descriptive of bromide, and showed to everyone that a bromide was a principal ingredient of the composition. The Court of Appeals reversed the Supreme Court of the state, and decided that "Bromo-Caffeine" was a valid trade-mark. They reasoned that, while it is true "bromo" might be presumed to refer to a bromide, yet there were many different kinds of bromides, and it could not be definitely determined to which of these several bromides the term "bromo" applied, and therefore the term was suggestive and not definitely descriptive, and this suggestiveness was not objectionable under the law. This decision of the Court of Appeals may be found in 37 N. E. Rep., 476, in the case of *Keasby* v. *Brooklyn Chemical Works.*

Applying that law to the present facts, we submit that the same conclusion must be reached, even if it be admitted (which it is not) that the prefix "pancreo" refers to "pancreatine." "Pancreatine," as we have seen, is a commercial, not a chemical term, and refers indiscriminately to one ferment or two ferments, or a combination of three ferments, or various other combinations and extracts; and the prefixes "pancreo" and "pancro" cannot possibly designate to which of these several combinations the term "pancreatine" is to be applied in the particular instance. These prefixes are therefore suggestive and not descriptive. The still stronger reason why these prefixes are suggestive and not descriptive is because they may be as readily derived from various other words as from "pancreatine," such as "pancratium," "pancreatic," "pancreas," "pancreazymose," etc.

In the case of *American Grocery Co.* v. *Sloan*, 68 Fed.

Rep., 539, the name "Momaja" was sustained as a valid trade-mark, although it was admitted in the decision that it was suggestive of a compound of Mocha and Java coffees, it, however, being held not sufficiently definite in its descriptive capacity as to invalidate it.

In the case of *N. K. Fairbank Co.* v. *Central Lard Co.*, 64 Fed. Rep., 133, the following ruling was made:

> "It seems clear that 'Cottolene' is a proper and valid trade-mark. Although it may suggest cotton-seed oil, it is not sufficiently descriptive to render it invalid as a trade-mark, under the recent decisions. The rule is that names suggestive of an old composition of articles may be valid trade-marks if not too accurately descriptive of their character or quality. . . ."

It is manifest that "Cottolene" is pretty close to the words from which the abbreviations were derived, which words were "cotton" and "oleine." The court also held in that case that the word used by the defendant, "Cott-oleo," was merely suggestive and not descriptive. The reasoning of the court as to this last-mentioned word is instructive, and is as follows:

> "'Cott' is merely *suggestive* of cotton oil. It does not *describe* it. And 'oleo' may describe or refer to 'Oleomargarine' as well as to 'Oleosterine,' or to other oils . . ."

This case certainly seems to be practically identical in principle with the one now before the court.

In the case of *Noel* v. *Ellis*, 86 O. G., 633, the term "Vitæ-Ore" was sustained, being held suggestive but not descriptive. The court said that if the words "Ore of Life" had been used they would not have been a valid trade-mark because descriptive, but that while "Vitæ" is the Latin of "life," it is still a fanciful word when coupled with the word "Ore," because it brought to it another

word which had not been theretofore connected with the word "Ore" as applied to a preparation of medicinal nature. The reasoning in that case would certainly apply to the present one, for Mr. Warner is proved by the evidence to have brought in connection with the word "pepsin" a prefix "pancreo," which had never been known either as a word or as a prefix.

The decision of the Court of Appeals for the Sixth Circuit in the case of *Paris Medicine Co.* v. *W. H. Hill Co.*, 102 Fed. Rep., 148, is quite instructive. In that case the term employed by the complainant was "Bromo-Quinine," and the defense was that this term was descriptive. The court below, in view of certain affidavits and a definition in the Standard Dictionary, reached the conclusion that the trade-mark was descriptive because used to infer that "bromo" was a leading constituent in the remedy. The Court of Appeals in passing upon the case used the following significant language:

> "Whether the word 'bromo' has or has not acquired a definite significance as a term of science indicating a compound in which 'bromine' is an element, is a matter upon which this court is not clear, and is therefore reluctant to disturb the order denying to complainant a temporary injunction. There is no finding and no proof as to whether there is known either in chemistry or medicine such a compound as 'Bromo-Quinine.'"

The court, however, refused to disturb the decision of the court below, on the ground that it was a preliminary injunction, and it was not clear as to the facts. The language used, however, suggested very clearly that in the mind of the court, if it could be proved that there was no such word as "Bromo-Quinine" known in chemistry or medicine, or that the word "bromo" had not acquired a definite significance as a term of science, the trade-mark

would have been valid. Now the present case comes directly within these suggestions, and therefore this decision of the Court of Appeals, we submit, is virtually in our favor. In the present case, as we have shown, there is positive proof that neither the word "pancreopepsine" nor the prefix "pancreo" was known either in chemistry or medicine at the time of Mr. Warner's adoption, and that the prefix "pancreo" never acquired a definite significance as a term of science indicative of the presence of pancreatine prior to the time of Mr. Warner's adoption, or at any other time. It seems, therefore, that the requirements of the Cincinnati Court of Appeals have been satisfied, and therefore, under the doctrine laid down in their decision, complainant's word "Pancreopepsine" is a valid trade-mark. In the case of *Paris Medicine Co.* v. *Newton C. Davis,* Judge Baker, in the District of Indiana, entered a decree January 22, 1898, sustaining the validity of the trade-mark Bromo-Quinine, and ordering a perpetual injunction.

In the case of *Battle Co.* v. *Finlay,* 45 Fed. Rep., 796, the word "Bromidia" was in question as a trade-mark, and defendants alleged that such term indicated that the chief element was bromide. The court held that "Bromidia" was nevertheless an arbitrary word and not descriptive, and it was therefore a valid trade-mark. It is manifest that the change from "bromide" to "bromidia" consists simply in eliding terminal "e" and substituting as a terminal "ia," and yet the court held that this slight change made it a fanciful term, which although suggestive was not descriptive. If this is correct, certainly complainant's trade-mark in this case is a valid one, for the difference is much more striking.

In the case of *Raymond* v. *Royal Baking Powder Co.,* 85 Fed. Rep., 231, the Court of Appeals of this the Sev-

enth Circuit held that the word "Royal" as applied to the entire manufacture of baking powder was a valid trade-mark, although in one sense it was descriptive of quality.

In the case of *Lloyd* v. *Wm. S. Merrill Chemical Co.*, 25 Weekly Law Bulletin, 319, the Cincinnati Supreme Court held valid as a trade-mark the word "Asepsin,' which was abbreviated from "Antiseptin," on the ground that although this coined word suggested the qualities of the article sold, yet it *could not be found as a word in any chemistry or medical authority*, and was therefore not definitely descriptive.

In the case of *Pennsylvania Salt Mfg. Co.* v. *Meyers*, 79 Fed. Rep., 87, the word "Saponifier" was held a proper trade-mark, although it was made up of the Latin word "sapo" (soap) and "fieri" (made), and therefore was clearly suggestive. The court said that at the time the complainant adopted the word "Saponifier" no such word had found its place in any lexicon, and although it would doubtless suggest some of the characteristics and qualities of the article, such suggestiveness is not fatal to its appropriation as a trade-mark, provided it is not definitely descriptive.

There are a great many more decisions on the point in question, but we submit that the authorities mentioned clearly elucidate the doctrine for which we have been contending, namely, that if a word is a coined word and cannot be found in any known lexicon as early as the date of adoption, the fact that it is suggestive, although not definitely descriptive, will not prevent its legal adoption as a trade-mark.

CONCLUSION.

By way of recapitulation, we would therefore submit:

1. That the Supreme Court has jurisdiction of this appeal, as it is a case arising under the Trade-Mark Statutes of the United States, and decisions of the Court of Appeals in such matters is not made final by the statute.

2. That the Supreme Court has jurisdiction of this appeal because the constitutionality of a statute of the United States is drawn in question, and a construction of the constitution required at the hands of the court.

3. That the Supreme Court has jurisdiction because the complainant has proved use of the trade-mark in commerce with foreign nations, and the defendant has counterfeited and copied such mark and applied it to goods of similar description, thereby furnishing grounds for asking relief at the hands of the Federal Court.

4. The trade-mark involved was new and original with and coined by complainant, and is not an old or descriptive term.

5. The defendant has counterfeited complainant's trade-mark by using a word constituting a mere colorable imitation.

Respectfully submitted,

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